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# A Restatement of Copyright Law as More Independent and Stable Treatise

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# A Restatement of Copyright Law as More Independent and Stable Treatise

Ann Bartow<sup>†</sup>

## INTRODUCTION: IT'S COMPLICATED

Copyrights are really complicated. Copyrights provide the owner, usually the creator of the copyrighted work at least initially, with legal rights, but the rights can have uncertain boundaries.<sup>1</sup> “Copyright law” technically derives from the federal Copyright Act and a host of federal court opinions. It also has a profound social meaning that only sporadically maps the actual statutory and jurisprudential prescriptions. Some simple misconceptions about copyright law result from lack of exposure to basic information.<sup>2</sup> Examples include a belief that holding a copyright requires filing paperwork with the government, which has not been true since early 1978,<sup>3</sup> and the false impression that if one credits an author whose work is copied, the copying cannot be copyright infringement<sup>4</sup> (or the reverse, that failing to credit an author of a work is a copyright infringement, which is also incorrect<sup>5</sup>). Others come about through acts of exaggeration or outright deception, such as the fear that making a single unauthorized copy of a song will bring the F.B.I to one's doorstep,

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<sup>†</sup> Professor of Law, Pace Law School of Pace University. The author thanks the ALI and Brooklyn Law School for prompting this project, with particular gratitude to Prof. Anita Bernstein. This article is dedicated to Casey Bartow-McKenney and an adorable little dog named Dobby.

<sup>1</sup> See generally Jessica Litman, *Real Copyright Reform*, 96 IOWA L. REV. 1 (2010).

<sup>2</sup> See generally *Common Copyright Myths*, CASE W. RES. U., <http://library.case.edu/copyright/cmyths.html> (last visited Oct. 4, 2013); Jonathan Bailey, *5 Important Copyright Misconceptions The Linger*, PLAGIARISM TODAY (Oct. 15, 2012), <http://www.plagiarismtoday.com/2012/10/15/important-copyright-misconceptions-that-linger/>. For basic information about copyright law see, e.g., *Taking the Mystery Out of Copyright*, LIBRARY OF CONGRESS, <http://www.loc.gov/teachers/copyrightmystery/text/> (last visited Oct. 7, 2013).

<sup>3</sup> *Copyright Basics*, UNITED STATES COPYRIGHT OFFICE, <http://www.copyright.gov/circs/circ01.pdf> (last visited Dec. 20, 2013).

<sup>4</sup> See Copyright Act of 1976, Pub. L. 94-553, 90 Stat 2541, 17 U.S.C. § 106 (2012). See e.g., *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, LTD.*, 545 U.S. 913 (2005); *Castle Rock Entm't v. Carol Publ'g Grp.*, 150 F.3d 132 (2d Cir. 1998).

<sup>5</sup> *UMG Recordings, Inc. v. Disco Azteca Distribs., Inc.*, 446 F. Supp. 2d 1164, 1178 (E.D. Cal. 2006).

a notion propagated by the music industry to discourage infringing acts of music downloading.<sup>6</sup>

Even fairly astute and proactive people can have a difficult time comprehending the complexities of various copyright doctrines. Consider how easy it is to misapprehend the work for hire doctrine even with a copy of the Copyright Act available. A smart and motivated lay person might decide to research the copyright ramifications of hiring an artist to paint a portrait of her adorable dog, and read the following:

§ 201. Ownership of copyright

(a) Initial Ownership. – Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work.

(b) Works Made for Hire. – In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

This makes it sound like the person commissioning the painting, because she is the person for whom the work is prepared, will be considered the author of the work even though someone else has fixed it in a tangible medium of expression.<sup>7</sup> Given the words “Copyright in a work protected under this title vests initially in the author or authors of the work” it therefore sounds like she will, as the statutorily designated “author” (even though she has not picked up a paintbrush) own the copyright in the painting as well as the painting itself, once the transaction is completed. She will see that the first clause of 201(b) limits its application to “the case of a work made for hire.” But nothing anywhere within the text of this statutory provision warns the reader to check the definition of “Works Made for Hire” in Section 101 of the Copyright Act where one learns that:

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<sup>6</sup> Marc Fisher, *Download Uproar: Record Industry Goes After Personal Use*, WASH. POST (Dec. 30, 2007), <http://www.washingtonpost.com/wp-dyn/content/article/2007/12/28/AR2007122800693.html>; Kashmir Hill, *Will the New ‘Copyright Alert System’ Actually Stop People From Downloading Music and Movies Illegally?*, FORBES (Feb. 25, 2013, 3:43 PM), <http://www.forbes.com/sites/kashmirhill/2013/02/25/copyright-alert-system/>; *Study: Legal Fears Scare Away Downloaders*, BILLBOARD, <http://www.billboard.com/biz/articles/news/1439107/study-legal-fears-scare-away-downloaders> (last visited Nov. 17, 2013).

<sup>7</sup> Legal Info. Inst., *Fixed in a Tangible Medium of Expression*, CORNELL.EDU, [http://www.law.cornell.edu/wex/fixed\\_in\\_a\\_tangible\\_medium\\_of\\_expression](http://www.law.cornell.edu/wex/fixed_in_a_tangible_medium_of_expression) (last updated Aug. 19, 2010).

A “work made for hire” is—

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a “supplementary work” is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an “instructional text” is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

It is only after reading and processing this definition that the person commissioning the painting could hope to understand that unless she qualifies as the painter’s employer, she cannot be the author of the work (and therefore the copyright owner) via the work for hire doctrine. She may be specially ordering or commissioning the painting, and she and the artist may produce and sign a detailed written agreement concerning the painting, but the painting still does not fit within any of the nine enumerated work for hire categories listed within the statute.<sup>8</sup> In consequence the “work for hire” option is not available to her.

She can still independently negotiate a transfer of the copyright from the painter as part of the deal she strikes when she commissions the work, but nothing in this part of the Copyright Act draws attention to this option. First she needs to understand that she has to buy the copyright separately from the painting, which actually is explained fairly clearly within Section 202 of the statute, if she knows what she is looking for, as follows:

Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which

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<sup>8</sup> See generally Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730 (1989) (holding that agency law was the appropriate source for a definition of employee for copyright purposes, and therefore sculptor was not an “employee,” and thus the work for hire doctrine did not apply). A commissioned painting would not ordinarily constitute a contribution to a collective work, a part of a motion picture or other audiovisual work, a translation, a supplementary work, a compilation, an instructional text, a test, answer material for a test, or an atlas. *Works Made for Hire*, UNITED STATES COPYRIGHT OFFICE, <http://www.copyright.gov/circs/circ09.pdf> (last visited Jan. 13, 2014).

the work is embodied. Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.

But that does not explain whether or how she can acquire the copyright in the painting from the artist. For that information she needs to head back to Section 201(d) of the Copyright Act, titled “Transfer of Ownership,” to learn that:

(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

(2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

And even once she figures out how to acquire the copyright, she still will not know, because it is not something anyone would be likely to predict or intuit, that as the statutory author, the artist, or the artist’s heirs can effectively repossess the copyright in the painting approximately 35 years after the transfer using termination rights established in Section 203 of the Copyright Act. Nothing in the other statutory provisions she consulted would be likely to point her in that direction. She would have to read the relevant and rather convoluted textual provisions of the Act, and understand that Congress wanted to make sure that authors or their heirs would be able to recapture their copyrights and have a second opportunity to capitalize on them.<sup>9</sup>

To untangle the practical applications of the work for hire doctrine, one would need to look at court opinions to chart the ways in which the work for hire doctrine has functioned or led to disputes under a variety of factual situations. Consultation with an interpretative guide such as a treatise or Restatement could be an efficient way to parse this out, at least initially. If the guide was accurate, straightforward, and comprehensive, using it

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<sup>9</sup> Brian D. Caplan & Jonathon J. Ross, *United States Copyright Termination Rights: What Does the Future Have in Store?*, 5 LANDSLIDE, January/February 2013, at 14; Larry Rother, *A Copyright Victory 25 Years Later*, N.Y. TIMES (Sept. 10, 2013), <http://www.nytimes.com/2013/09/11/arts/music/a-copyright-victory-35-years-later.html>.

would be a smart and productive first step. Unfortunately, no such guide exists.

- I. “EXPERIENCE HAS TWO THINGS TO TEACH: THE FIRST IS THAT WE MUST CORRECT A GREAT DEAL; THE SECOND THAT WE MUST NOT CORRECT TOO MUCH.”<sup>10</sup>

Copyright law needs to undergo simplifying reform. On this point at least, most stakeholders and commentators—authors, publishers, distributors, technologists, lawyers, academics and consumers—seem to agree.<sup>11</sup> Maria A. Pallante, Register of Copyrights of the United States Copyright Office, recently informed the House Subcommittee on Courts, Intellectual Property, and the Internet:

Thank you for the opportunity to appear before you today to discuss the state of our copyright law. My message is simple. The law is showing the strain of its age and requires your attention. As many have noted, authors do not have effective protections, good faith businesses do not have clear roadmaps, courts do not have sufficient direction, and consumers and other private citizens are increasingly frustrated. The issues are numerous, complex, and interrelated, and they affect every part of the copyright ecosystem, including the public at large. For reasons that I will explain, Congress should approach the issues comprehensively over the next few years as part of a more general revision of the statute. A comprehensive effort would offer an occasion to step back and consider issues both large and small, as well as whether and how they relate to the equities of the statute as a whole. This Subcommittee in particular has an opportunity to do what it has done in the past, not merely to update particular provisions of copyright law, but to put forth a forward-thinking framework for the benefit of both culture and commerce alike.

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I think it is time for Congress to think about the next great copyright act, which will need to be more forward thinking and flexible than before. Because the dissemination of content is so pervasive to life in the 21st century, the law also should be less technical and more helpful to those who need to navigate it. Certainly some guidance could be given through regulations and education. *But my point is, if*

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<sup>10</sup> Eugene Delacroix, in *THE HARPER BOOK OF QUOTATIONS* (Robert I. Fitzhenry ed., 3rd ed. 1993).

<sup>11</sup> See generally Litman, *supra* note 1; Pamela Samuelson, *Preliminary Thoughts On Copyright Reform*, 2007 UTAH L. REV. 551 (2007); see also ROBERT LEVINE, *FREERIDE: HOW DIGITAL PARASITES ARE DESTROYING THE CULTURE BUSINESS, AND HOW THE CULTURE BUSINESS CAN FIGHT BACK* (2011); JASON MAZZONE, *COPYFRAUD AND OTHER ABUSES OF INTELLECTUAL PROPERTY LAW* (2011); WILLIAM PATRY, *HOW TO FIX COPYRIGHT* (2012); cf. ROBERT P. MERGES, *JUSTIFYING INTELLECTUAL PROPERTY* (2011).

*one needs an army of lawyers to understand the basic precepts of the law, then it is time for a new law.*<sup>12</sup>

Unsurprisingly, most copyright stakeholders pushing for changes to the current copyright law are driven by self-interest, and their tools for legal reform are forged by instrumentalism, rather than neutrality. One of the central theoretical debates within copyright law is whether incentivizing the creation and distribution of new works is best achieved with high or low levels of protection. Though some empirical work exists, for the most part proponents of both sides of the debate rely largely on analytic persuasiveness to make their cases.<sup>13</sup>

One might expect staunch fidelity to one pole position or the other by most players. Yet as a practical matter, few copyright stakeholders evince a consistent viewpoint on the optimal height at which statutory barriers should be constructed.<sup>14</sup> For example, while most copyright holders favor strong protections for the works to which they hold copyrights, they overwhelmingly prefer weak protections for the works of others whose copyrights they are accused of infringing. Alternatively, creative consumers can make powerful arguments about the debilitating effect that copyright maximalism has upon free speech and the diffusion of culture when they invest their own time, talents, and sweat equity in user-generated content such as audiovisual mashups<sup>15</sup> or fan fiction.<sup>16</sup>

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<sup>12</sup> *The Register's Call for Updates to U.S. Copyright Law: Hearing Before the Subcomm. on Courts, Intellectual Prop. and the Internet of the H. Comm. on the Judiciary*, 113th Cong. (Mar. 20, 2013) (statement of Maria A. Pallante, Reg. of Copyrights, U.S. Copyright Office) (emphasis added), available at [http://www.copyright.gov/regstat/2013/regstat03202013.html#\\_ftn1](http://www.copyright.gov/regstat/2013/regstat03202013.html#_ftn1).

<sup>13</sup> See, e.g., Ryan Radia, *A Balanced Approach to Copyright*, CATO UNBOUND (Jan. 11, 2013), <http://www.cato-unbound.org/2013/01/11/ryan-radia/balanced-approach-copyright>.

<sup>14</sup> See, e.g., Brandon Butler, *Great Fair Use Advice From Reed Elsevier (Seriously!)*, ARL POLICY NOTES, <http://policynotes.arl.org/post/53359448111/great-fair-use-advice-from-reed-elsevier-seriously> (last visited Nov. 17, 2013).

<sup>15</sup> *Mash-up Definition*, DICTIONARY.COM, <http://dictionary.reference.com/browse/mash-up> (last visited Nov. 17, 2013); Ryan B., *Mashup: A Fair Use Defense*, YALE L. & TECH. (Feb. 4, 2010), <http://www.yalelawtech.org/ip-in-the-digital-age/mashup-a-fair-use-defense/>; Phil Morse, *Over to You: Is It Legal to DJ with Unofficial Mashups and Remixes?*, DIGITAL DJ TIPS (May 8, 2011), <http://www.digitaldjtips.com/2011/05/over-to-you-is-it-legal-to-dj-with-unofficial-mashups-and-remixes/>.

<sup>16</sup> *Fan Fiction Definition*, DICTIONARY.COM, <http://dictionary.reference.com/browse/fan+fiction?s=t> (last visited Nov. 17, 2013); Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, and a New Common Law*, 17 LOY. L.A. ENT. L. REV. 651 (1997); Jane Litte, *Q&A with Professor Rebecca Tushnet*, DEAR AUTHOR (Mar. 21, 2012), <http://dearauthor.com/features/essays/qa-with-professor-rebecca-tushnet/>; see also Nick Gillespie & Joshua Swain, *Fan Fiction vs. Copyright – Q&A with Rebecca Tushnet*, REASON.COM (July 20, 2012, 3:00 PM), <http://reason.com/blog/2012/07/20/fan-fiction-vs-copyright-qa-with-rebecca>.

Their rhetoric is less compelling, though, when it is applied to the unauthorized downloading of a song simply to avoid the 99 cent purchase price.<sup>17</sup>

There is an embedded and similarly seemingly intractable dispute about the specificity and applicability of the individual stipulations that are, or should be, imposed by copyright law. Statutory provisions that are drafted to be precise and unambiguous offer clarity, but may also impose unreasonable rigidity upon dynamic creative relationships best served by malleable laws that offer the widest range of interpretive options. To demonstrate: distilling the scope of fair use, the doctrine allowing some unauthorized use of copyrighted works, into percentages or word counts is potentially liberating to creators who like to weave snippets of existing works into their own. As long as they stay within statutorily constructed metes and bounds of a granularly iterated fair use statute, they have nothing to fear from infringement suits. Some kinds of works, such as musical compositions that utilize short samples of existing songs, or literary works relying on brief quotations, would flourish. But the same approach could prove completely incapacitating to prospective fair users who need more than snippets of existing works to craft effective transformative works of their own, such as parodists, biographers, and historians. To illustrate this in a different way, explicitly legalizing the unauthorized appropriation of 10% or less of a work as a bright line alternative to the current fair use provision of the Copyright Act might prove very generous to someone seeking to transform portions of a 1,000 page novel, but devastatingly miserly to the putative transformer of a painting or a photograph.

Copyright law is comprised of a dauntingly long and complicated governing statute, and an immense body of case law. It is not surprising that there is a healthy market for interpretative guides to copyright law! Even people who dedicate substantial portions of their professional lives to teaching and researching copyright law find copyright treatises helpful sometimes, and reasonably so. Copyright treatises can

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<sup>17</sup> The discourse around unauthorized music downloading is complicated, and there are certainly times when doing so constitutes fair use, or a *de minimis* civil infraction at worst. My point is simply that making unauthorized literal copies just to avoid small fees is less defensible than transformative uses, not that it is in any sense indefensible. See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (holding that while “transformative use is not absolutely necessary for a finding of fair use, the goal of copyright . . . is generally furthered by the creation of transformative works”) (internal citations omitted).



serve the important function of providing an efficient starting point for researching a point of doctrine. When a copyright treatise is routinely also the end point of research, however, analytic capture by the treatise author is facilitated, potentially short-circuiting healthy debate on particular issues and ignoring the concerns of some of the stakeholders.

Law professors can have a unique role in the development of any area of the law because we can sit back and analyze issues without our attentions or conclusions being driven or restrained by the best interests of clients. But law professors specializing in copyright law have had limited success in persuading either Congress or the courts to make needed changes. The problem is not a lack of useful academic writings on the subjects within the purview of the Copyright Act. There are many brilliant law review articles that make a host of sensible normative recommendations, and many legal scholars have written trenchant critiques describing misinterpretations or misapplications of copyright law. But the practical effect of most of this work has generally been quite modest. Judges rarely credit legal scholarship with persuasive power on thorny analytical questions.<sup>18</sup> Copyright treatises are not the only reason these articles are so often ignored, but they are surely a factor. Courts rely too heavily on copyright treatises when they are deciding copyright cases, as evidenced by both their citation practices and their substantive legal decisions.<sup>19</sup> This is a big problem if the treatise consulted is biased or paints inaccurate or incomplete pictures of important issues.

In 2011 Chief Justice John G. Roberts Jr. suggested that there is a disconnect between the legal scholarship produced by law professors and the needs and desires of the legal profession. He included jurists in his list of practitioners who are unlikely to productively engage with law review articles, while answering questions at a judicial conference in June of 2011, saying:

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<sup>18</sup> See Adam Liptak, *The Lackluster Review that Lawyers Love to Hate*, N.Y. TIMES (Oct. 21, 2013), [http://www.nytimes.com/2013/10/22/us/law-scholarships-lackluster-reviews.html?\\_r=0](http://www.nytimes.com/2013/10/22/us/law-scholarships-lackluster-reviews.html?_r=0); cf. Jack Chin, *Getting Law Review Fans Out of the Closet: Liptak on Jacobs and Waxman*, PRAWFSBLAWG (Oct. 21, 2013, 6:30 PM), <http://prawfsblawg.blogs.com/prawfsblawg/2013/10/getting-law-review-fans-out-of-the-closet-liptak-on-jacobs-and-waxman.html>; Frank Pasquale, *Glass Houses: Liptak on Legal Scholarship*, BALKINIZATION BLOG (Oct. 22, 2013, 1:56 PM), <http://balkin.blogspot.com/2013/10/glass-houses-liptak-on-legal-scholarship.html>.

<sup>19</sup> Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581 (2004).

Pick up a copy of any law review that you see, and the first article is likely to be, you know, the influence of Immanuel Kant on evidentiary approaches in 18th Century Bulgaria, or something, which I'm sure was of great interest to the academic that wrote it, but isn't of much help to the bar . . . . If the academy wants to deal with the legal issues at a particularly abstract, philosophical level . . . that's great and that's their business, but they shouldn't expect that it would be of any particular help or even interest to the members of the practice of the bar or judges.<sup>20</sup>

University of Maryland law school professor Sherrilyn Ifill wrote in reply:

Legal scholars will on occasion indeed take up Kant (and there's no shame in that), but more often than not, published law review articles offer muscular critiques on contemporary legal doctrine, alternative approaches to solving complex legal questions, and reflect a deep concern with the practical effect of legal decision-making on how law develops in the courtroom.<sup>21</sup>

She correctly noted that there are many law review articles that would provide great help to judges, if they would read them.<sup>22</sup> Ifill said that Roberts apparently intended to

shame academics with what he regards as our own scholarly irrelevance. But the shame is really on the Chief Justice of the United States, who demonstrated how out of touch he is with the current world of legal scholarship and the potential contribution of legal scholars to the work of judges.<sup>23</sup>

In October of 2013, journalist-with-a-law-degree Adam Liptak<sup>24</sup> published an article in the *New York Times* that decried the uselessness of law review articles, citing the Roberts quote for support, along with similar words from Second Circuit Judge Dennis Jacobs and former Solicitor General Seth

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<sup>20</sup> *Law Prof. Ifill Challenges Chief Justice Roberts' Take on Academic Scholarship*, ACS BLOG (July 5, 2011), <http://www.acslaw.org/acsblog/law-prof-ifill-challenges-chief-justice-roberts%E2%80%99take-on-academic-scholarship>; see also *Annual Fourth Circuit Court of Appeals Conference*, C-SPAN (June 25, 2011), <http://www.c-span.org/Events/Annual-Fourth-Circuit-Court-of-Appeals-Conference/10737422476-1/>.

<sup>21</sup> Debra Cassens Weiss, *Law Prof. Responds After Chief Justice Roberts Disses Legal Scholarship*, ABA J. (July 7, 2011, 4:29 AM), [http://www.abajournal.com/news/article/law\\_prof\\_responds\\_after\\_chief\\_justice\\_roberts\\_disses\\_legal\\_scholarship/](http://www.abajournal.com/news/article/law_prof_responds_after_chief_justice_roberts_disses_legal_scholarship/); Danielle Citron, *Sherrilyn Ifill on What the Chief Justice Should Read on Summer Vacation*, CONCURRING OPINIONS (July 1, 2011, 4:06 PM), <http://www.concurringopinions.com/archives/2011/07/sherrilyn-ifill-on-what-the-chief-justice-should-read-on-summer-vacation.html>.

<sup>22</sup> Citron, *supra* note 21.

<sup>23</sup> *Id.*; ACS BLOG, *supra* note 20.

<sup>24</sup> *Adam Liptak*, N.Y. TIMES, [http://topics.nytimes.com/top/reference/timestopics/people/l/adam\\_liptak/index.html](http://topics.nytimes.com/top/reference/timestopics/people/l/adam_liptak/index.html) (last visited Nov. 17, 2013).

Waxman.<sup>25</sup> As law professor Jack Chin trenchantly observed, however, both Waxman and Judge Jacobs have actually cited law review articles fairly frequently.<sup>26</sup> Fellow law professor Frank Pasquale additionally noted that a law review article can have substantial impact that cannot be measured by judicial citations.<sup>27</sup>

And yet, really good law review articles on important topics can be completely overlooked.<sup>28</sup> In my opinion, this is especially true with copyright law. Every year significant numbers of accessible articles about copyright law are written from a wide range of theoretical and practical perspectives, and published in a wide variety of periodicals and formats.<sup>29</sup> A small portion of them are cited by the courts, but this cohort is overshadowed by the number of citations to copyright treatises, the Nimmer treatise in particular, although the Goldstein and Patry treatises also get some attention. Some of these citations are to portions of treatises containing straightforward descriptions of settled points of law. Other times, a treatise simply declares what the law is regardless of where courts have been on the matter. Fans of particular copyright treatises have informally credited them with being “forward-leaning” or “out ahead of the case law.”<sup>30</sup> Sometimes, however, a treatise tries to actually drive the case law, and sometimes it succeeds.

## II. “LEADING” IS NOT ALWAYS A GOOD QUALITY IN A TREATISE

As illustrated above, the Copyright Act is complicated, often counterintuitive, and frequently amended.<sup>31</sup> In an institution as august as the Library of Congress, if you have a question about copyright law, you might well be directed to

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<sup>25</sup> Liptak, *supra* note 18.

<sup>26</sup> Chin, *supra* note 18.

<sup>27</sup> Pasquale, *supra* note 18.

<sup>28</sup> See e.g., Frank Pasquale, *Private Prison Problems (and the Scholars Who Warned Us)*, BALKANIZATION BLOG (Oct. 23, 2013, 10:27 AM), <http://balkin.blogspot.com/2013/10/private-prison-problems-and-scholars.html>.

<sup>29</sup> See, e.g., Pamela Samuelson, *Is Copyright Reform Possible?*, 126 HARV. L. REV. 740, 740 n.1 (2013) (book review).

<sup>30</sup> Those are words the author heard used to describe the Nimmer treatise by its fans in casual conversation. Cf. Alexandra Goldstein, *Nimmer on Copyright Celebrates 50 Years*, COPYRIGHT ALLIANCE (May 9, 2013), [https://copyrightalliance.org/2013/05/nimmer\\_copyright\\_celebrates\\_50\\_years#.Umv\\_anCsgyo](https://copyrightalliance.org/2013/05/nimmer_copyright_celebrates_50_years#.Umv_anCsgyo). For a more formal estimation of a copyright treatise, see generally J. H. Reichman, *Goldstein on Copyright Law: A Realist's Approach to a Technological Age*, 43 STAN. L. REV. 943 (1991) (book review).

<sup>31</sup> Samuelson, *supra* note 11, at 551-53.

consult the Nimmer treatise for an answer.<sup>32</sup> *Nimmer on Copyright*, a law librarian there has recently written, “is an exhaustive source on all areas of copyright” and “is cited in over 3000 federal decisions in the United States and is routinely relied on as the authoritative source in copyright litigation.”<sup>33</sup> According to one account of a recent event held at the Library of Congress to celebrate the Nimmer treatise<sup>34</sup>

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<sup>32</sup> Over a decade ago I published an article entitled *The Hegemony of the Copyright Treatise*, in which I warned about the powerful but underappreciated influence that the Nimmer copyright treatise has had upon the development of copyright law, particularly in the courts. Ann Bartow, *supra* note 19, at 583. The article got a little bit of positive online attention by copyright scholars, and was cited a few times by law professors. See INFORMATION, LAW, AND THE LAW OF INFORMATION (Jan. 11, 2007), <http://blogs.law.harvard.edu/infolaw/2007/01/11/back-to-the-future-of-copyright-treatises/>; Ray Corrigan, *Bartow's Critique of Copyright Treatise Hegemony*, B2FXXX (Feb. 8, 2005, 6:28 PM), <http://b2fxxx.blogspot.com/2005/02/bartows-critique-of-copyright-treatise.html>; *The Hegemony of the Copyright Treatise*, COPYFIGHT (Feb. 2, 2005), [http://copyfight.corante.com/archives/2005/02/02/the\\_hegemony\\_of\\_the\\_copyright\\_treatise.php](http://copyfight.corante.com/archives/2005/02/02/the_hegemony_of_the_copyright_treatise.php); William McGeveran, *Back to the Future of Copyright Treatises?*, INFO/LAW (Jan. 11, 2007), <https://blogs.law.harvard.edu/infolaw/2007/01/11/back-to-the-future-of-copyright-treatises/>. But in the main, the article was ignored. Everyone continued to cite to the Nimmer treatise apace, and judicial citations actually rose even though the number of copyright cases resulting in written opinions actually declined.

David Nimmer's only written reaction of which I am aware to the article is found within a footnote in his treatise, where he wrote:

For a further disagreement not only with this treatise but with just about every other treatise writer and judge who has ever weighed in on this issue, combined with a critique of reliance on any other part of this treatise for good measure, see Anne Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581, 610-40 (2004). Unaccountably, that critic also contends that this treatise “does not often cite law professors,” *id.* at 641, a proposition easily refuted by perusal herein.

1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.07[A][3][c] n.32 (Matthew Bender, rev. ed. 2013). Since this footnote appears within the section of the treatise entitled “Identification of Joint Authors,” I assume the section of my article addressing this issue is what he is referencing, but with an overly broad pinpoint cite that should instead list pages 618-28. I do not disagree in the article or as a matter of course with Nimmer's take on the issue, or with “just about every other treatise writer and judge who has ever weighed in on this issue.” In addition to spelling my first name incorrectly, Nimmer mischaracterizes my discussion of the relevant cases, which is an entirely descriptive effort to track the evolution of the jurisprudence on this matter not unlike his handling of the various strands of analysis. I expressly take no position on the correct interpretive outcome, as evinced rather unambiguously in a parenthetical that states “this article takes no position on that issue,” Bartow, *supra*, note 19, at 623, and in fact credit Nimmer's exposition of the Second Circuit's position as correct a few pages later, *id.* at 627.

<sup>33</sup> Jeanine Cali, *Nimmer on Copyright, 1st Edition – Pic of the Week*, in CUSTODIA LEGIS (May 24, 2013), <http://blogs.loc.gov/law/2013/05/nimmer-on-copyright-1st-edition-pic-of-the-week/>.

<sup>34</sup> “*Nimmer on Copyright*” Now Available as Video Podcast, NEWSNET (July 9, 2013), <http://www.copyright.gov/newsnet/2013/511.html>.

(which culminated in a Nimmer treatise festschrift in the Winter 2013 edition of the Journal of the Copyright Society<sup>35</sup>):

Robert Brauneis, who has done significant research on the judicial impact of Nimmer on Copyright, detailed the decisions that have cited the treatise since its inception. The presentation revealed an overwhelming tie between Nimmer's guide and federal and Supreme Court decisions, *highlighted by one year in which almost 98% of copyright cases cited to Nimmer on Copyright*.<sup>36</sup>

One academic fan of the Nimmer Treatise recently asserted that "As the single most influential treatise in the area of copyright law, and one that is routinely referenced by courts at all levels, the Nimmer treatise plays an underappreciated behind-the-scenes role in facilitating the continued development of the common law of copyright among courts across the country."<sup>37</sup> The Nimmer treatise's two major competitors are the Goldstein treatise and the Patry treatise. Very basic Boolean searches conducted on Westlaw and Lexis federal court databases roughly chart the relative impact of these three treatises on the judiciary as follows: According to Westlaw, the Nimmer treatise has 3,018 citations, the Goldstein treatise has 215 and the Patry treatise has 194

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<sup>35</sup> See Goldstein, *supra* note 30 ("And amongst other things, in addition to our annual meeting and our mid-winter meeting—the annual meeting [of the Copyright Society] is coming up shortly—we publish the Journal of the Copyright Society of the USA, and on your way in you got a document that shows the table of contents for our next edition, which is a tribute to David and Melville Nimmer's Nimmer on Copyright."); Cory Field, *Melville Nimmer the Writer: A Review of the 1963 First Edition of Nimmer on Copyright on the Occasion of the Fiftieth Anniversary of its Publication*, 60 J. COPYRIGHT SOC'Y U.S.A. 157, 157 (2013):

From our present perspective in 2013, Nimmer on Copyright by Melville B. Nimmer and David Nimmer has become a monument of legal scholarship: eleven volumes cited almost 3,100 times by the courts since it was published in 1963. But all enduring monuments must first be carved out of stone, in a painstaking process where every chisel stroke must follow the grand design. And all legal treatises, no matter how authoritative on the law, must begin and end with words. The better the words, the better the law.

In honor of the fiftieth anniversary of the publication of Nimmer on Copyright, we return to the original source, the one-volume 1963 first edition written by Melville B. Nimmer, to consider how a consummate legal writer used words to express himself on the topic of copyright law, and in so doing created a style of writing, philosophy of enquiry, and standard of uncompromising questioning about the law that still resonates. After fifty years, we best honor the work of a legal writer the way we best honor any author, by reading his words as they were first offered to the world.

<sup>36</sup> Goldstein, *supra* note 30 (emphasis added).

<sup>37</sup> Shyamkrishna Balganesh, *Stewarding the Common Law of Copyright*, 60 J. COPYRIGHT SOC'Y 103, 104 (2013).

citations.<sup>38</sup> According to Lexis the Nimmer treatise has 3,189 citations, the Goldstein treatise has 239 and the Patry treatise has 174.<sup>39</sup> The Nimmer treatise has been around the longest, and is available electronically on the Lexis database. The Patry treatise, which was the Latman treatise in a prior iteration, and was heavily revised in 2007, is available electronically on the Westlaw database.<sup>40</sup> The Goldstein treatise does not seem to be available electronically other than via CCH, which is expensive and rumored to have comparatively few subscribers in consequence.<sup>41</sup> This has probably negatively affected its use and popularity quite dramatically. Because of the overwhelming dominance of the Nimmer treatise, it is the primary critical focus of this article.

The publisher of the Nimmer treatise has advertised the work in venues like the *ABA Law Journal* by touting its popularity. A sample advertisement states: “When the problem is copyright, most attorneys look to one of the texts most frequently cited by the courts: NIMMER ON COPYRIGHT. It is the only comprehensive treatise that *tells you what the law says and what it means.*”<sup>42</sup>

Federal courts have referred to the Nimmer treatise as the “leading treatise” on copyright law well over one hundred times,<sup>43</sup> and even the Supreme Court occasionally cites it in lieu of researching a more appropriate citation. For one recent and notable example, the Supreme Court opinion in *Golan v. Holder* contains citations to the Nimmer treatise rather than the Congressional Record for the proposition that a limited retroactivity provision of the North American Free Trade Agreement Implementation Act was replaced a year later by Congress with the litigated version of 17 U.S.C. § 104A.<sup>44</sup> The

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<sup>38</sup> Search Results, WESTLAWNEXT, <https://1.next.westlaw.com> (login; then search for “Nimmer w/3 copyright,” “Goldstein w/3 copyright” and “Patry w/3 copyright”) (last visited June 27, 2013).

<sup>39</sup> Search Results, LEXIS ADVANCE, <https://advance.lexis.com> (login; then search for “Nimmer w/3 copyright,” “Goldstein w/3 copyright” and “Patry w/3 copyright”) (last visited June 27, 2013).

<sup>40</sup> Patry took over the Latman treatise in 1986. See WILLIAM F. PATRY, LATMAN’S THE COPYRIGHT LAW (1986). Goldstein began publishing his treatise in 1989. See PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE (1989).

<sup>41</sup> *Goldstein on Copyright*, CCH ONLINE STORE, <http://onlinestore.cch.com/productdetail.asp?productid=3179> (last visited Nov. 17, 2013).

<sup>42</sup> 56 A.B.A. Journal 407, 408 (May 1970) (emphasis in original).

<sup>43</sup> Search Results, WESTLAWNEXT, <https://1.next.westlaw.com> (login; then search “All Federal” for “Nimmer /35 leading /2 treatise”) (last visited June 27, 2013).

<sup>44</sup> *Golan v. Holder*, 132 S. Ct. 873, 880 n.5 (2012) (citing 3 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 9A.03, 9A.04, pp. 9A-17, 9A-22 (2011)) (“NAFTA ultimately included a limited retroactivity provision—a precursor to § 514 of

Court also cited the Nimmer treatise to provide support for an explanation of the very meaning of restoration in the context of this statutory provision,<sup>45</sup> again apparently trumping actual legislative history in authority.

One can find examples of the Nimmer treatise serving as proxy for legislative history throughout the Supreme Court's copyright jurisprudence. Back in 1985, in *Harper & Row v. The Nation*, which is deeply unfavorable to both copyright's fair use doctrine and the First Amendment's free speech clause, Justice O'Connor cited the treatise to support the proposition that "the statutory formulation of the defense of fair use in the Copyright Act reflects the intent of Congress to codify the common law doctrine."<sup>46</sup> She went on to rely upon the Nimmer treatise for the explosive contention<sup>47</sup> that "it has never been seriously disputed that 'the fact that the plaintiff's work is unpublished . . . is a factor tending to negate the defense of fair use,'"<sup>48</sup> and the treatise's assertion that "the fact that a work is unpublished is a critical element of its 'nature' in crafting the Court's majority opinion."<sup>49</sup> As events transpired, however, Congress itself disputed the concept of the unpublished nature of a work negating fair use quite vociferously in the wake of the *Harper & Row* decision by adding to Section 107 of the Copyright Act the

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the URAA—granting U.S. copyright protection to certain Mexican and Canadian films. These films had fallen into the public domain between 1978 and 1988 for failure to meet U.S. notice requirements. One year later, Congress replaced this provision with the version of 17 U.S.C. § 104A at issue here." (citations omitted)).

<sup>45</sup> *Id.* at 882 n.13 (citing 3 M. NIMMER & D. NIMMER, *supra* note 44 § 9A.04[A][1][b][iii], at 9A-26 & n.29.4) ("Restoration is a misnomer insofar as it implies that all works protected under § 104A previously enjoyed protection. Each work in the public domain because of lack of national eligibility or subject-matter protection, and many that failed to comply with formalities, never enjoyed U.S. copyright protection.").

<sup>46</sup> *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549 (1985).

<sup>47</sup> See, e.g., William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1661, 1674-75 (1988); Gary L. Francione, *Facing The Nation: The Standards for Copyright, Infringement, and Fair Use of Factual Works*, 134 U. PA. L. REV. 519, 533 (1986); W. Warren Hamel, *Harper & Row v. The Nation: A First Amendment Privilege for News Reporting of Copyrightable Material?*, 19 COLUM. J. L. & SOC. PROBS. 253, 301-02 n.268 (1985); Owen B. Cooper, Note, *Fair Use of Copyrighted Work Under Harper & Row Publishers, Inc. v. Nation Enterprises*, 61 TUL. L. REV. 415, 422 (1986); Stacy Daniels, Note, *Harper & Row Publishers, Inc. v. Nation Enterprises: Pirating Unpublished Copyrighted Works: Does the Fair Use Doctrine Vindicate First Amendment Rights?*, 19 J. MARSHALL L. REV. 501, 509 (1986); Robin Feingold, Note, *When "Fair is Foul": A Narrow Reading of the Fair Use Doctrine in Harper & Row Publishers, Inc. v. Nation Enterprises*, 72 CORNELL L. REV. 218, 232-37 (1986); Greg A. Perry, Note, *Copyright and the First Amendment: Nurturing the Seeds for Harvest*, 65 NEB. L. REV. 631, 648-49 (1986); Timothy V. Phelps, Note, *Copyright: The Public Figure Expansion of the Fair Use Doctrine Rejected*, 25 WASHBURN L.J. 385, 392-93 (1986); *The Supreme Court, 1984 Term—Leading Cases*, 99 HARV. L. REV. 120, 294-95 (1985).

<sup>48</sup> *Harper & Row*, 471 U.S. at 551.

<sup>49</sup> *Id.* at 564.

phrase: “The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.”<sup>50</sup>

It was also in *Harper & Row* that the Supreme Court quoted and adopted the Nimmer treatise’s admonition that the final factor of Section 107’s four-part fair use test,<sup>51</sup> “the effect of the use upon the potential market for or value of the copyrighted work” was “undoubtedly the single most important element of fair use.”<sup>52</sup> This was a deeply problematic contention because it suggests that any use that potentially affects the market or value of a copyrighted work cannot be a fair one, severely compressing the doctrine.<sup>53</sup> The Court later fixed this Nimmer-influenced mistake itself, in its most important nonliteral copying fair use case, *Campbell v. Acuff-Rose*, dialing back the importance of commercial use in a fair use evaluation.<sup>54</sup>

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<sup>50</sup> The Copyright Act of 1992, Pub. L. 102–492, 106 Stat. 3145 (1992) (as amended at 17 U.S.C. § 107 (2012)); see generally Daniel E. Wanat, *Fair Use and the 1992 Amendment to Section 107 of the 1976 Copyright Act*, 1 VILL. SPORTS & ENT. L.F. 47 (1994).

<sup>51</sup> 17 U.S.C. § 107 (2012). Limitations on exclusive rights: Fair use

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

<sup>52</sup> *Harper & Row*, 471 U.S. at 566 (citing 3 M. NIMMER & D. NIMMER, *supra* note 44, § 13.05[A], at 13-76) (“Finally, the Act focuses on ‘the effect of the use upon the potential market for or value of the copyrighted work.’ This last factor is undoubtedly the single most important element of fair use.”).

<sup>53</sup> Wendy J. Gordon & Daniel Bahls, *The Public’s Right to Fair Use: Amending Section 107 to Avoid the “Fared Use” Fallacy*, 2007 UTAH L. REV. 619, 657; Lydia Pallas Loren, *Redefining the Market Failure Approach to Fair Use in an Era of Copyright Permission Systems*, 5 J. INTEL. PROP. L. 1, 6-7 (1997); cf. Wendy J. Gordon, *Fair Use Markets: On Weighing Potential License Fees*, 79 GEO. WASH. L. REV. 1814 (2011); but see Ashten Kimbrough, Note, *Transformative Use vs. Market Impact: Why the Fourth Fair Use Factor Should Not Be Supplanted by Transformative Use as the Most Important Element in a Fair Use Analysis*, 63 ALA. L. REV. 625, 627 (2012).

<sup>54</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 572 (1994).



Ironically, it perhaps obliviously cited the Nimmer treatise while doing so, though of course to a section other than the fourth factor “single most important element” analysis the Court rejected.<sup>55</sup> The current version of the Nimmer treatise still doggedly maintains with respect to the fourth factor: “If one looks to the fair use cases, if not always to their stated rationale, this emerges as the most important, and indeed, central fair use factor.”<sup>56</sup>

Ironically, in his capacity as an attorney, treatise founder Melville Nimmer filed an amicus brief in *Harper & Row v. Nation Enterprises* on behalf of Gannett, a large media company, urging affirmance by the Supreme Court of the Second Circuit’s decision that what the *Nation* did was fair use. Attorney Nimmer’s amicus brief was apparently inadequately persuasive. Instead the majority reversed, with Justice O’Connor citing or referencing the Nimmer treatise 20 times in her opinion. The dissent by Justice Brennan cited or referenced the Nimmer treatise an additional six times. Reading through both with a precise focus on the Nimmer treatise citations and references creates a powerful impression that no matter what statement one wanted to make about fair use, one can find support for that contention in the Nimmer treatise. Perusal of the current version of the treatise does nothing to disabuse one of that notion. Seemingly any position on a fair use question is susceptible to a Nimmer citation. Whether this is a strength or a weakness of this section of the work is in the eye of the beholder.

At times it can appear as if a Justice cites to the Nimmer treatise by rote, as if it is a necessary, check-the-box sort of exercise even when the treatise adds little of substance to a topic. In the recent Supreme Court case *Kirtsaeng v. John Wiley & Sons, Inc.*,<sup>57</sup> both the majority and dissenting opinions cite to the Nimmer treatise on the extraterritorial operation of copyright law with absolutely zero utility in terms of diagnostically framing the issue. The case involved a dispute about inexpensive foreign-made textbooks, which third parties were importing into the United States and selling on eBay for

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<sup>55</sup> *Id.* at 590 (citing 3 M. NIMMER & D. NIMMER, *supra* note 44, § 13.05[A] [4], p. 13-102.61.) (“The fourth fair use factor is ‘the effect of the use upon the potential market for or value of the copyrighted work.’ § 107(4). It requires courts to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also ‘whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market’ for the original.” (citations omitted)).

<sup>56</sup> 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[A][4] (Matthew Bender, Rev. Ed. 2013) (citations omitted).

<sup>57</sup> 133 S. Ct. 1351 (2013).

huge profits despite the objections of copyright-holding publishers. The Court held that if a copy was made legally, lawfully acquired abroad, and then imported into the United States, it could be resold within the United States without the copyright owner's permission because there is no geographic restriction on Section 109's "first sale" doctrine.<sup>58</sup> The majority opinion penned by Justice Breyer textually cites to the Nimmer treatise with a *cf.* signifier, laying down a choppy parenthetical crediting the tome with: "noting that the principle that 'copyright laws do not have any extraterritorial operation' 'requires some qualification.'" <sup>59</sup> Why he even bothered is hard to fathom.

The ardent dissent written by Justice Ginsburg embraces the first contention only, citing the identical section of the Nimmer treatise for the parenthetical proposition that "[C]opyright laws do not have any extraterritorial operation."<sup>60</sup> But that was not the only time Justice Ginsburg invoked the treatise, and the *Kirtsaeng* dissent ultimately cited all three of the mentioned copyright treatises, noting at one impassioned analytic juncture: "It is unsurprising that none of the three major treatises on U.S. copyright law embrace the Court's construction of § 109(a)."<sup>61</sup> Her Nimmer citations make a bit more sense, at least to the extent that not ruling in a way that is consistent with copyright treatises implies that the Court is in error.

One commentator has observed that "Nimmer never misses an opportunity to exhibit leadership, to set forth his view of how the law should proceed in future cases, inviting judges to follow his lead."<sup>62</sup> In lower court opinions, one can find contextual citations which suggest that judges can place too much weight on the prescriptions of the Nimmer treatise, and fail to engage in enough independent analysis. For example, in *Silvers v. Sony* a district court judge adopted a very expansive view of standing primarily because the Nimmer treatise told him to, writing:

To support its claim of standing, Plaintiff relies principally on *Nimmer on Copyright*. Nimmer opines that "the assignee of an accrued infringement cause of action has standing to sue without the

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<sup>58</sup> *Id.* at 1358.

<sup>59</sup> *Id.* at 1359-60.

<sup>60</sup> *Id.* at 1376 (Ginsburg, J., dissenting).

<sup>61</sup> *Id.* at 1391 (Ginsburg, J., dissenting) (citing 2 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.12[B][6][c], at 8-184.34 to 8-184.35; 2 Goldstein § 7.6.1.2(a), at 7:141; 4 Patry §§ 13:22, 13:44, 13:44.10).

<sup>62</sup> Corey Field, *Melville Nimmer the Writer: A Review of the 1963 First Edition of Nimmer On Copyright on the Occasion of the Fiftieth Anniversary of its Publication*, 60 J. COPYRIGHT SOC'Y U.S.A. 157, 162 (2013).

need to join his assignor, even if the latter retains ownership of all other rights under the copyright.” Nimmer § 12.02[B]. In support of that proposition, the treatise cites *Prather v. Neva Paperbacks, Inc.*, 410 F.2d 698 (5th Cir. 1969).

*Prather* appears to support Plaintiff’s position. The Fifth Circuit seemed to suggest that a plaintiff could have standing to sue, even if the plaintiff were not a copyright holder or exclusive licensee, based simply on an assignment of an accrued cause of action. The court stated: “overlooked by all counsel is the effectiveness of an assignment of accrued causes of action for copyright infringement.” 410 F.2d at 700. This statement is dictum, however, because the plaintiff in *Prather* was assigned both the accrued causes of action and the copyright rights. The Fifth Circuit’s decision thus does not answer whether the assignment of the cause of action *alone* is sufficient to confer standing.

That being said, the Court is nevertheless persuaded that Plaintiff has standing to pursue the copyright claim in this case. Various facts influence the Court’s decision. *First, the leading treatise on the subject, Nimmer on Copyright, a source frequently cited by the Supreme Court as authority on copyright law, rejects Eden Toys and opines that the assignment of an accrued cause of action is effective to confer standing on the assignee, even though the assignor retains all interests in the copyright.*<sup>63</sup>

So the first reason proffered for the ruling is that it is in accord with the dictates of Nimmer! Although the judge astutely noticed that the Nimmer treatise did not support its own positivist declaration of law with actual substantiating holdings, he seemed to rule for the Plaintiff primarily based on what the Nimmer treatise said the law should be, which among other things offered a secure doctrinal position for entities popularly referred to as “copyright trolls.”<sup>64</sup> Copyright trolls are entities whose business model is using mass copyright litigation to extract quick settlements from individual defendants who want to avoid the costs and possible embarrassment of protracted litigation.<sup>65</sup> Given that it proffered no supporting case law, the Nimmer treatise was perhaps signaling to readers that this was speculation rather than settled law, but also that this was what the law should be. Ultimately an *en banc* panel of the Ninth Circuit disagreed with both the district court judge and the suggestions of

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<sup>63</sup> Order Granting In Part And Denying In Part Defendant’s Motion To Dismiss, *Silvers v. Sony Pictures Ent., Inc.*, No. CV 00-6386 SVW (RCx), 2001 WL 36127624, at \*2 (C.D. Cal. Jan. 25, 2001) (emphasis added).

<sup>64</sup> *Copyright Trolls*, ELECTRONIC FRONTIER FOUND., <https://www EFF.org/issues/copyright-trolls> (last visited Nov. 17, 2013).

<sup>65</sup> For further discussion, see *Copyright Troll Stories*, TECHDIRT, <http://www.techdirt.com/blog/?tag=copyright+troll> (last visited Nov. 17, 2013).

Nimmer treatise on this issue.<sup>66</sup> That opinion became the basis for the Ninth Circuit's recent rejection of the claim in *Righthaven, LLC v. Hoehn* that Righthaven had standing to sue for copyright infringement without holding any ownership interest in the copyright, simply on the basis of agreements granting it the bare right to sue for infringement.<sup>67</sup> Many copyright troll leery commentators were quite relieved by this outcome.<sup>68</sup>

#### A. Questioning Authorities

While bringing passion to one's work is admirable, sometimes treatise writers may get a little too wrapped up in their work, to the detriment of the tome's perceived balance or neutrality. For example, consider the somewhat melodramatic tone that pervades the "Identification of Joint Authors" section of the Nimmer treatise.<sup>69</sup> The Copyright Act defines a "joint work" as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."<sup>70</sup> In laying out the requirements for qualifying as a co-author for joint authorship purposes, the Nimmer treatise states that "A large volume of exegesis arises here."<sup>71</sup> Nimmer asserts that the contribution to the finished work must be "more than *de minimis*" and one of

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<sup>66</sup> *Silvers v. Sony Pictures Entm't, Inc.*, 402 F.3d 881 (9th Cir. 2005) (en banc), reversing No. CV 00-6386 SVW (RCx), 2001 WL 36127626 (C.D. Cal. Mar. 29, 2001).

<sup>67</sup> *Righthaven, LLC v. Hoehn*, 716 F.3d 1166, 1169-71 (9th Cir. 2013).

<sup>68</sup> Michael P. Boudett, *Another Blo Is Struck Against Monetization of Copyright Enforcement Claims*, MONDAQ (June 3, 2013), <http://www.mondaq.com/unitedstates/x/242692/Copyright/Another+Blow+Is+Struck+Against+Monetization+Of+Copyright+Enforcement+Claims+Trademark+And+Copyright+Law>; Eric Goldman, *Copyright Trolling Is Really Hard to Do Profitably—Righthaven v. Hoehn*, TECH. & MKTG. L. BLOG (May 9, 2013), [http://blog.ericgoldman.org/archives/2013/05/copyright\\_troll.htm](http://blog.ericgoldman.org/archives/2013/05/copyright_troll.htm); Devlin Hartline, *A Closer Look at the Righthaven Standing Issue*, COPYHYPE (Mar. 26, 2013), <http://www.copyright.com/2013/03/a-closer-look-at-the-righthaven-standing-issue-4/>; David Lat, *Benchslap of the Day: Ninth Circuit Smacks Copyright Trolls*, ABOVE THE LAW (May 9, 2013, 4:08 PM), <http://abovethelaw.com/2013/05/benchslap-of-the-day-ninth-circuit-smacks-copyright-trolls/>; Mike Masnick, *Righthaven Copyrights 'Sold' Back to Stephens Media for \$80k to Pay Legal Fees*, TECHDIRT (Mar. 18, 2013, 7:39 AM), <http://www.techdirt.com/articles/20130316/02363422348/righthaven-copyrights-sold-back-to-stephens-media-80k-to-pay-legal-fees.shtml>; Cy Ryan, *Appeals Court Rules That Righthaven Lacked Standing To Sue Over Copyrights*, LAS VEGAS SUN (May 19, 2013, 5:13 PM), available at <http://www.lasvegassun.com/news/2013/may/09/appeals-court-rules-righthaven-lacked-standing-sue/>; cf. *Assignment to Sue for Copyright Not Enough for Standing – Appeals Court*, LEGAL MONITOR WORLDWIDE (May 10, 2013), <https://1.next.westlaw.com> (sign in; then search "2013 WLNR 11547754"); *Copyright Assertion Entities Must Have the Exclusive* . . . , WASH. INTERNET DAILY (May 13, 2013), <https://1.next.westlaw.com> (sign in; then search "2013 WLNR 11960933").

<sup>69</sup> 1 M. NIMMER & D. NIMMER, *supra* note 32, § 6.07.

<sup>70</sup> 17 U.S.C. § 101 (2012).

<sup>71</sup> 1 M. NIMMER & D. NIMMER, *supra* note 32, § 6.07 [A].

authorship, but that it “need not itself be separately copyrightable.”<sup>72</sup> It is on this third point that the emotion invested in his preferred interpretation becomes apparent. First, Nimmer observes that “[t]he most contentious issue in this domain revolves around whether A and B must each contribute material that, standing alone, would be separately copyrightable in order to style them joint authors. *As we shall see, uncertainty and disagreement punctuate these issues.*”<sup>73</sup> Then, Nimmer explains that no requirement for a separately copyrightable contribution can be found within the text of the Copyright Act or its legislative history, writing:

That language contains no requirement that each contribute an independently copyrightable component to the product. The legislative history similarly elevates intention as the touchstone, without placing any further parsing as to the copyrightable status of each individual component that the parties intend to contribute to the work as a whole.<sup>74</sup>

Next, he makes a policy pitch, stating that:

It is submitted that copyright’s goal of fostering creativity is best served, particularly in the motion picture context, by rewarding all parties who labor together to unite idea with form, and that copyright protection should extend both to the contributor of the skeletal ideas and the contributor who fleshes out the project.<sup>75</sup>

Finally, there are words of self-congratulatory glee, crowing that on the putatively “solitary” issue of copyright law that courts had strayed from treatise dictates on, there had been a positive development:

The thrust of the decisions summarized above seemed clear enough by the start of 2004 to lead to this writer’s concession that on this solitary issue alone, among the myriad propositions advanced throughout these many volumes, the courts had soundly rejected the instant treatise’s point of view. But news of the death of the idea-contributor-as-joint-author doctrine proved to be greatly exaggerated. For no sooner did that concession appear in print than the Seventh Circuit described this treatise’s point of view as “heretical”—and then proceeded to choose it!<sup>76</sup>

Evidence about the intentions of the people involved at the time a potentially joint work is produced can be crucial to

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<sup>72</sup> *Id.*

<sup>73</sup> *Id.* § 6.07 [A][3] (emphasis added).

<sup>74</sup> *Id.* § 6.07 [A][3][a].

<sup>75</sup> *Id.*

<sup>76</sup> *Id.* § 6.07 [A][3][c].

joint authorship determinations. But when intention evidence is conflicted or lacking, some judges seem to feel more confident ruling against a putative joint author on the basis that an “independently copyrightable contribution” has not been made.<sup>77</sup> What’s most interesting to me about all this is that plaintiffs asserting joint authorship through litigation almost never prevail,<sup>78</sup> as courts seem extremely nervous about making it too easy for someone to sue herself into joint authorship status with respect to a commercially successful work. What seems to be most interesting to David Nimmer, however, is whether judges will capitulate to the treatise and follow his dictates in this matter. He describes opposing points of view as “resistance,”<sup>79</sup> and courts that disagree with his analysis as “applying the rejectionist view.”<sup>80</sup> He further informs the reader that “[o]ne court acknowledged that applying the rejectionist view may have produced what might be considered an unjust result.”<sup>81</sup> Then, because the Seventh Circuit agreed with him in one instance, the treatise subsection following “Resistance” is entitled “Vindication,” and is comprised of a lengthy explication of the case and why “now that the camel’s nose is under the tent, it is ripe to re-examine the rejectionist point of view.”<sup>82</sup>

Consider another example of Nimmer explicitly trying to mold the law. Law Professor Christopher Newman recently noted that over a decade of commentary on a case concerned with copyright assignments and licenses, *Gardner v. Nike*,<sup>83</sup> “has been uniformly and vociferously critical” and that “*Gardner*’s critics assert—with no little vehemence—that the holding blatantly contradicts the statutory text and legislative history, and that it runs counter to the policy of copyright

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<sup>77</sup> See NINTH CIRCUIT JURY INSTRUCTION COMMITTEE, NINTH CIRCUIT MANUAL OF MODEL JURY INSTRUCTIONS CIVIL 374-75 (2007), available at <http://www3.ce9.uscourts.gov/jury-instructions/node/264>; Abbott M. Jones, Note, *Yours, Mine, and Ours: The Joint Authorship Conundrum for Sound Recordings*, 10 VAND. J. ENT. & TECH. L. 13, 16-17 (2008); *Sources for Joint Authorship Module*, CYBER L. HARV., <http://cyber.law.harvard.edu/metaschool/fisher/joint/sources.html> (last visited Nov. 11, 2013) (listing articles and cases).

<sup>78</sup> See e.g., *Aalmuhammed v. Lee*, 202 F.3d 1227, 1227 (9th Cir. 2000); *Childress v. Taylor*, 945 F.2d 500, 500 (2d Cir. 1991); *Thomson v. Larson*, 147 F.3d 195, 195 (2d Cir. 1998).

<sup>79</sup> 1 M. NIMMER & D. NIMMER, *supra* note 32, § 6.07 [A][3][b].

<sup>80</sup> *Id.*

<sup>81</sup> *Id.* § 6.07[A][3][b] (internal quotation marks omitted).

<sup>82</sup> *Id.* § 6.07 [A][3][c].

<sup>83</sup> *Gardner v. Nike*, 279 F.3d 774 (9th Cir. 2002).

divisibility adopted in the 1976 Act.”<sup>84</sup> This impassioned criticism came not only from interested parties, but is found within the pages of the Nimmer and Patry treatises as well.<sup>85</sup> Patry calls it “one of the most baffling copyright opinions ever,” while Nimmer, ever the activist, calls for the case not to be followed altogether.<sup>86</sup> Again, an example of Nimmer advocating for changes in the law rather than simply explaining it.

Of course David Nimmer has every right to opine within the pages of his own treatise any way he likes. Treatise readers simply need to remain cognizant of the fact that the same urge to win arguments that moves lawyers in practice and law professors within the pages of law review articles like this can also animate and energize treatise writers, and they can get overinvested in victory. Additionally, they may parlay their association with a treatise into lucrative work as expert witnesses, with mixed success.<sup>87</sup>

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<sup>84</sup> Christopher M. Newman, *An Exclusive License Is Not an Assignment: Disentangling Divisibility and Transferability of Ownership in Copyright*, 74 LA. L. REV. (forthcoming 2014), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2286833](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2286833).

<sup>85</sup> See 3 M. NIMMER & D. NIMMER, *supra* note 44, § 10.02 [B][4][b] (Matthew Bender, Rev. Ed. 2013) (criticizing *Gardner* and suggesting that it “should not be followed”); 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 5:103 (2013) (calling it “one of the most baffling copyright opinions ever” and “decision making run amok”).

<sup>86</sup> Newman, *supra* note 84.

<sup>87</sup> Treatise readers also need to carefully consider how much depth or gravitas a treatise author brings to any particular issue. In a copyright dispute over the television series “My Name is Earl,” David Nimmer was excluded as an expert witness by Judge Wilson of the Central District of California, who wrote:

Here, Plaintiff has not demonstrated that Nimmer is qualified to render an expert opinion on the issue of substantial similarity between two literary works. Nimmer’s experience, training, and education establish that Nimmer undoubtedly is an expert in the field of copyright law. He is a graduate of Yale Law School, and a partner at the Los Angeles-based firm of Irell & Manella. He specializes in and teaches copyright law and is the current author of the preeminent copyright treatise *Nimmer on Copyright*, which is often cited by appellate courts, including the Supreme Court. Over the past three decades, Nimmer has published numerous books and dozens of articles on copyright law, spoken at many copyright law conferences, and taught seminars to federal judges on the issue of substantial similarity in copyright law. Given this extensive background, there can be no question that Nimmer is well-qualified to perform a *legal analysis* regarding copyright claims. However, as discussed below, an expert cannot offer his legal opinion as to whether a triable issue of fact exists regarding copyright infringement; such an analysis is the exclusive province of the Court.

Instead, the relevant issue on summary judgment, and indeed the subject matter upon which Nimmer seeks to opine, is whether there is substantial similarity in the objective elements of theme, plot, dialogue, characters, sequence of events, mood, pace, and setting between *Karma!* and *Earl*. In short, Nimmer was tasked with performing a literary analysis of two fiction works. However, Nimmer offers little explanation as to how his legal expertise qualifies him to compare a screenplay and a television series on the

Every copyright treatise is filled with legal conclusions. Some of them are well supported by case law, while others may not be. And some of them may be written with a hidden, or at least obfuscated, agenda, as when a treatise writer is

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eight criteria mentioned. Notably absent from Nimmer's report and declarations is any indication that Nimmer has experience, knowledge, training, or education in the literary field—for example, there is no evidence that Nimmer has ever worked as a film critic, a publisher, an English professor, an editor or director, that Nimmer writes fiction works, or even that Nimmer is an avid movie buff or television-watcher. While the Court recognizes that the task of comparing two fiction works is not highly technical, and indeed requires no specific training, to offer an *expert literary analysis* there must be some indication that Nimmer has, in one capacity or another, watched, read, written, compared and/or analyzed literary works. No such evidence exists here.

Further, Nimmer's prior experience as an expert witness or consultant, with perhaps one or two exceptions, is not relevant to the literary analysis offered in this case. Nimmer lists several cases in which he previously offered expert testimony regarding the substantial similarity of works such as technical drawings, architectural plans, bingo cards, instructions for the use of pesticides, and computer software. Nimmer does not explain the specific analysis he performed; however, his assignments in those cases did not involve fiction works such as television shows, plays, movies, or books. Thus, this prior experience does not inform the literary analysis offered here. There are two instances in which Nimmer may have performed a similar analysis as that offered here, although given the vague descriptions of these assignments, it is difficult to know for certain. First, Nimmer declares that he assisted a publisher in overturning an injunction in a copyright case involving a comparison between Margaret Mitchell's *Gone with the Wind* and Alice Randall's *The Wind Done Gone*. But Nimmer fails to describe the issue that he was asked to analyze or the opinion he ultimately rendered in that case. Nimmer also notes one assignment, in *Time Warner Entertainment Co. v. Continental Casualty Co.*, Case No. 02-01885 R (C.D. Cal.), where he was asked to compare a revised screenplay with the motion picture *Contact* and concluded that the unlicensed, protectable expression from the screenplay that was used in the film gave rise to a valid copyright claim. While this prior experience appears relevant, the fact that Nimmer testified as an expert once before in a case involving literary works is not a sufficient basis, without more, to accept his testimony here.

In sum, Nimmer's specialized knowledge of copyright law and his legal expertise does not qualify him as a literary expert. . . . As such, Nimmer's opinions as to the points of similarity between *Karma!* and *Earl* are not admissible.

Gable v. Nat'l Broad. Co., 727 F. Supp. 2d 815, 833-35 (C.D. Cal. 2010) (footnotes omitted) (citations omitted). On appeal the Ninth Circuit panel did not view this as an abuse of discretion, writing in an unpublished opinion:

The district court also did not err in excluding expert testimony from David Nimmer and Eric Sherman. Some of Nimmer's testimony contained inadmissible legal conclusions. According to the district court, although each were recognized to have a separate area of expertise, both Nimmer and Sherman also failed to establish that they had "knowledge, skill, experience, training, or education" relevant to the evidence at issue. Fed. R. Evid. 702.

Gable v. Nat'l Broad Co., 438 F. App'x 587 (9th Cir. 2011) (footnotes omitted) (citations omitted).



attempting to change the law without clearly informing the reader of this mission.

*B. Advocacy Versus Accuracy*

Media companies engage in a lot of Congressional lobbying to influence the crafting of statutory provisions that affect them. They also drive much of the high cost and high impact copyright litigation in the United States. To the extent that a copyright treatise functions as a source of copyright law rather than simply a description of it, the addition or revision of a treatise section in a way that was generally favorable to media companies could function a bit like lobbying Congress in terms of influencing the future development of pertinent provisions of the law. Below are a few examples of the impact a treatise can have upon copyright law writ large.

1. Termination Rights

Copyright termination rights give some authors an opportunity to regain ownership of their copyrights many years after they licensed them away.<sup>88</sup> The Nimmer treatise contains a lengthy attack<sup>89</sup> upon Second Circuit and Ninth Circuit opinions on copyright termination rights<sup>90</sup> that interpret language in the Copyright Act making these termination rights non-waivable in a manner he strongly disagrees with. Here is just a short excerpt:

The formulation “[t]ermination of the grant may be effected notwithstanding any agreement to the contrary” plainly means that authors and their successors may terminate copyright assignments in spite of any contractual device that purports to divest them of the right; the express legislative intent was to override *Fisher* by guaranteeing that authors and their successors have the opportunity to regain copyright “notwithstanding any agreement to the contrary.”

The Supreme Court has remarked that such termination of transfer rights is “inalienable.” Yet *Milne* and *Steinbeck* effectively held that statutory successors’ termination rights are alienated when the copyright owner renegotiates an existing grant. Those decisions not only harm the statutory successors of innumerable copyrights, but also undermine Congress’s intention of shielding authors from the

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<sup>88</sup> Brian D. Caplan, *Navigating U.S. Copyright Termination Rights*, WIPO MAG. (Aug. 2012), [http://www.wipo.int/wipo\\_magazine/en/2012/04/article\\_0005.html](http://www.wipo.int/wipo_magazine/en/2012/04/article_0005.html).

<sup>89</sup> 3 M. NIMMER & D. NIMMER, *supra* note 44, § 11.07 [C]–[D].

<sup>90</sup> Caplan & Ross, *supra* note 9, at 14.

pressures of unequal bargaining power that had produced unremunerative transfers in the creative arts. At base, they substitute a subjective judicial balancing rule for a clear, legislatively established, categorical rule.

The question at hand is not whether the legislative determination constraining freedom of contract was the best policy for addressing the problem of unremunerative transfers in the realm of copyrighted works. Given that Congress already chose that policy, the instant critique is that *Milne* and *Steinbeck* overstep judicial authority within our constitutional structure.

Those rulings implicate numerous valuable copyrights, as all copyrights that are not works-made-for-hire are subject to termination. Furthermore, although those rulings construed the section of the Copyright Act governing the right to terminate grants in works that achieved protection before 1978 (§ 304(c)), the coordinate provision of the Copyright Act governing the right to terminate post-1978 grants (§ 203) includes the identical provision that “[t]ermination of the grant may be effected notwithstanding any agreement to the contrary . . . .” Therefore, when grants in post-1978 works become terminable beginning in 2013, courts can be expected to rely on *Milne* and *Steinbeck* to determine whether an author has the right to terminate. Unfortunately, authors and their successors can expect protracted courtroom battles when they attempt to enforce their statutorily mandated recapture rights.<sup>91</sup>

There are several possible explanations for the extended critique of the courts here. Maybe Nimmer simply has strong personal feelings about the issue. Or maybe this is because his preexisting treatise analysis was explicitly parsed and rejected by the Second Circuit in the *Steinbeck* case he rails against.<sup>92</sup> Or, it may be because he was the losing attorney in the Ninth Circuit “Pooh Properties” *Milne* case that he criticizes so harshly.<sup>93</sup> Possibly all three of these factors had an impact. Additionally, (as with *Steinbeck*) the Ninth Circuit opinion in *Milne* was expressly critical of the Nimmer treatise, holding:

Clare’s sole support for her position is found in a treatise authored by the late-Professor Melville Nimmer. In his treatise, Professor Nimmer expressed his *assumption* that this subsection—which on its face applies only to the statutory termination of a prior copyright

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<sup>91</sup> 3 M. NIMMER & D. NIMMER, *supra* note 44, § 11.07 [D][1].

<sup>92</sup> Penguin Grp. (USA) Inc. v. Steinbeck, 537 F.3d 193, 193 (2d Cir. 2008) (“We also reject the suggestion that, notwithstanding the plain language of the 1994 Agreement, there was no effective termination of the 1938 Agreement because the 1994 Agreement provided no opportunity—no ‘moment of freedom’—for those holding the termination right to renegotiate the terms of the grant. Appellees draw support for this theory primarily from *Nimmer on Copyright* § 11.07 (6th ed. 1978), referring to 17 U.S.C. § 304(c)(6)(D).”).

<sup>93</sup> *Milne ex rel. Coyne v. Stephen Slesinger, Inc.*, 430 F.3d 1036, 1037, 1048 (9th Cir. 2005).

grant—is intended to benefit authors and should therefore be extended to prohibit a simultaneous contractual termination and re-grant of copyright rights. See 3 M. NIMMER, NIMMER ON COPYRIGHT § 11.07(6th ed.1978). Clare's counsel, however, conceded at oral argument that no source of primary authority has endorsed this assumption. We too decline to do so.<sup>94</sup>

I personally think that Nimmer's treatise-described approach best effectuates the policy goals of terminations rights, and in consequence his reading of the statute is justifiable and correct. But the Nimmer approach failed big when it was field tested. A better approach for a treatise writer would be to openly disclose and discuss his personal involvement in litigating one of the cases, and then simply recount the approaches that courts have taken in these cases and offer a measured critique that the reader would understand represented the editor's informed opinion and hopes for the future. For example, the Patry treatise's coverage of the *Milne* case is very detailed but also quite straightforward, containing observations such as:

The critical question is whether, on the facts presented, the 1983 agreement was a permissible revocation of the 1930 agreement, or was instead a disguised "agreement to the contrary." As a general principle, section 304(c)(5) does not purport to prohibit parties from amending or replacing pre-1978 agreements, nor does that section prohibit all contractual activity, only agreements that purport to waive terminate rights. The nature of the 1983 agreement was ultimately a question of fact, and here the court's familiarity with those facts and the parties' conduct justifies its conclusion, if not its reasoning.<sup>95</sup>

Thus, Patry calmly explains what the court did, and gives a lucid explanation for why it reached a result that might not have been well reasoned, forgoing florid comments such as: "Given how fervently Congress tried in 1976 to eliminate the baleful consequences of *Fisher*, it is terribly unfortunate that courts are again falling into the same trap."<sup>96</sup> Whether Nimmer's own intense fervence will release courts back into the wild unharmed remains to be seen.

## 2. Fact v. Law in Fair Use

It is also interesting to note that David Nimmer has materially changed one portion of the treatise concerning fair

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<sup>94</sup> *Id.* at 1047 (emphasis in original).

<sup>95</sup> 3 PATRY, *supra* note 85, § 7:46.

<sup>96</sup> 3 M. NIMMER & D. NIMMER, *supra* note 44, § 11.07 [D][2].

use on summary judgment whilst characterizing his father Melville's position as old, and his own as "the modern view,"<sup>97</sup> which perhaps is more polite than simply declaring himself correct. In my view the issue continues to lack a clear answer. Melville Nimmer argued against analyzing fair use on summary judgment,<sup>98</sup> much less as a pure matter of law.<sup>99</sup> He held the view that fact findings were necessary to appropriately ascertain whether a contested non-permissive use of a work was fair. The current version of the Nimmer treatise states: "[T]he older view is that the issue whether similarity between two works is fair use presented a triable issue of fact. Under the modern view . . . the court may resolve the fair use defense as a matter of law on summary judgment."<sup>100</sup> Though correctly noting a change in the jurisprudence, the treatise treats the matter as black letter law, when in fact the law is unsettled. Some courts treat the inferences in the four-factor analysis as triable issues of fact for a jury,<sup>101</sup> while other courts examine the inferences as pure matters of law.<sup>102</sup>

### 3. Making Available

The Nimmer treatise has also reversed its position on the "making available" right.<sup>103</sup> David Nimmer's explanation for the change is that he was persuaded by the scholarship of law

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<sup>97</sup> See 3 M. NIMMER & D. NIMMER, *supra* note 44, § 12.10 [B][4] & n.115.

<sup>98</sup> For a lengthy discussion of the issue, see Ned Snow, *Judges Playing Jury: Constitutional Conflicts in Deciding Fair Use on Summary Judgment*, 44 U.C. DAVIS L. REV. 483 (2010).

<sup>99</sup> See *Higgins v. Baker*, 309 F. Supp. 635, 637 (S.D.N.Y. 1969) ("Professor Nimmer, in his treatise on the law of copyright, suggests that the issue of 'fair use' presents questions of fact and thus should not be determined on a motion for summary judgment. MELVILLE NIMMER, NIMMER on Copyright § 138, at 600 (1969).").

<sup>100</sup> 3 M. NIMMER & D. NIMMER *supra* note 44, § 12.10[B][4], at 12-193 & n.115.

<sup>101</sup> See, e.g., *Compaq Computer Corp. v. Ergonome, Inc.*, 387 F.3d 403, 411 (5th Cir. 2004) ("The evidence presented at trial and the reasonable inferences therefrom, when viewed through the lens of the statutory fair use factors, support the jury's fair use finding."); *Herzog v. Castle Rock Entm't*, 193 F.3d 1241, 1247 (9th Cir. 1999) ("Summary judgment historically has been withheld in copyright cases because courts have been reluctant to make subjective determinations . . .").

<sup>102</sup> See, e.g., *Castle Rock Entm't v. Carol Publ'g Grp., Inc.*, 955 F. Supp. 260, 267, 272-74 (S.D.N.Y. 1997) (noting that fair use "is ordinarily a factual question for the jury to determine" and then justifying its summary judgment treatment on grounds that the historical facts enabled the judge to engage in four-factor analysis—implying that the inferences in the four-factor analysis are pure issues of law). Profound thanks to Ned Snow for this observation and the supporting citations in this and the preceding footnote; see also, Snow, *supra* note 98.

<sup>103</sup> INT'L FED'N OF THE PHONOGRAPHIC INDUS., THE WIPO TREATIES: 'MAKING AVAILABLE' RIGHT (March 2003), available at <http://www.ifpi.org/content/library/wipo-treaties-making-available-right.pdf>.

professor Peter Menell.<sup>104</sup> To prove a violation of the distribution right, most (though certainly not all) courts have held that a copyright owner needs to show an actual act of distribution of its content has taken place.<sup>105</sup> Content owners prefer that a simple offer to distribute that content suffice, so that “making available” is itself a violation and no proof that anyone took advantage of this opportunity is required.<sup>106</sup>

The distinction is of profound importance in the online context, where under the first view simply posting something to a website without authorization is not an infringement unless someone actually downloads it,<sup>107</sup> but simply making the content available for potential downloading is an automatic infringement under the second view.<sup>108</sup> As recently as 2011,<sup>109</sup>

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<sup>104</sup> See 1 NIMMER, *supra* note 32 § 8.11 and accompanying footnotes; see also Peter S. Menell, *In Search of Copyright's Lost Ark: Interpreting the Right to Distribute in the Internet Age*, 59 J. COPYRIGHT SOC'Y U.S.A. 1, 20 n.90 (2011) (“The discussion that follows is based upon the version of Nimmer on Copyright that was available to jurists and practitioners through August 2011. After reading this article, Professor Nimmer asked me to co-author a complete revision of the sections of Nimmer on Copyright relating to the scope of the distribution right and the definition of ‘publication.’”); Rick Sanders, *Is Nimmer & Menell's “Lost Ark” of Copyright Just a Prop?*, AARON SANDERS PLLC (May 30, 2013), <http://www.aaronsanderslaw.com/blog/is-nimmer-menells-lost-ark-of-copyright-just-a-prop>.

<sup>105</sup> *Does the Copyright Act Encompass a Making Available Right*, COPYRIGHT & TRADEMARK BLOG (Aug. 29, 2011), <http://copymarkblog.com/2011/08/29/does-the-copyright-act-encompass-a-making-available-right/>; Rick Sanders, *Will Professor Nimmer's Change of Heart on File Sharing Matter*, 15 VAND. J. ENT. & TECH. L. 857 (2013), available at <http://www.jetlaw.org/wp-content/uploads/2013/05/Sanders.pdf>; John Horsfield-Bradbury, *“Making Available” as Distribution: File-Sharing and the Copyright Act*, 22 HARV. J. L. & TECH. 273 (2008).

<sup>106</sup> Rick Sanders, *Is Nimmer & Menell's “Lost Ark” of Copyright Just a Prop?*, AARON SANDERS PLLC (May 30, 2013), <http://www.aaronsanderslaw.com/blog/is-nimmer-menells-lost-ark-of-copyright-just-a-prop>.

<sup>107</sup> Sanders, *supra* note 105; Horsfield-Bradbury, *supra* note 105.

<sup>108</sup> Sanders, *supra* note 105. In his copyright blog William Patry noted that

[i]n a routine suit against downloading via KaZaA, and in an opinion that focused almost entirely on the consequences of spoliation of evidence, Judge Cynthia Rufe of the Eastern District of Pennsylvania, in *Motown Records Co. v. Theresa DePietro*, Civ. No. 04-CV-2246 (Feb. 16, 2007)(HT to Paul Fakler), tossed off these remarks (p. 7):

A plaintiff claiming infringement of the exclusive-distribution right can establish infringement by proof of actual distribution or by proof of offers to distribute, that is proof that the defendant “made available” the copyrighted work. While neither the United States Supreme Court nor the Third Circuit has confirmed a copyright holder's exclusive right to make the work available, the Court is convinced that 17 U.S.C. § 106 encompasses such a right based on its reading of the statute, the important decision in *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Circuit 2001), and the opinion offered by the Register of Copyrights, Marybeth Peters, in a letter to Congressional hearings on piracy of intellectual property on peer-to-peer networks, Letter from Marybeth Peters, Register of

the Nimmer treatise said that making a work available was insufficient to establish distribution.<sup>110</sup> Now it says the reverse.<sup>111</sup> This change dramatically drives this aspect of copyright law in a direction that benefits large content owners such as music and movie companies.

Nimmer characterizes the issue in the treatise as an “interpretative puzzle” rather than a matter of ascertainable jurisprudence,<sup>112</sup> which obscures the rather stunning nature of the transformation. After concluding that courts “are deeply divided on the scope of the distribution right,” a highly debatable assertion, the treatise states:

The point of commonality among these opinions is that none of them went back to examine the rich trove of legislative materials from the early to mid-1960s and early 1970s explicating Congress’s intent in shifting terminology from the 1909 rights to publish and vend to the

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Copyrights, to Rep. Howard Berman, from the 28th Dist. of Cal. (Sept. 25, 2002) (“[M]aking [a work] available for other users of [a] peer to peer network to download . . . constitutes an infringement of the exclusive distribution right, as well as the reproduction right.”).

William Patry, *A Making Available Right?*, PATRY COPYRIGHT BLOG (Mar. 2, 2007, 11:39 AM), <http://williampatry.blogspot.com/2007/03/making-available-right.html> (alterations in original).

<sup>109</sup> See Menell, *supra* note 104, at 20 n.90 (“The discussion that follows is based upon the version of Nimmer on Copyright that was available to jurists and practitioners through August 2011.”).

<sup>110</sup> See *e.g.*, *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1217 (D. Minn. 2008) (citing 2 M. NIMMER & D. NIMMER, *supra* note 61, § 8.11 [A]) (“Additionally, the leading copyright treatises conclude that making a work available is insufficient to establish distribution.”); *Atl. Recording Corp. v. Howell*, 554 F. Supp. 2d 976, 976 (D. Ariz. 2008) (quoting 2 M. NIMMER & D. NIMMER, *supra* note 61, § 8.11[A]) (“Infringement of [the distribution right] requires an actual dissemination of either copies or phonorecords.”); *Elektra Entm’t Group, Inc. v. Barker*, 551 F. Supp. 2d 234, 243 (S.D.N.Y. 2008) (quoting 2 M. NIMMER & D. NIMMER § 8.11 [A] n.2) (“[N]ote that an offer to distribute copies or phonorecords to the public may in itself constitute a ‘publication,’ while the right of distribution apparently is not infringed by the mere offer to distribute to members of the public.”).

<sup>111</sup> See, *e.g.*, Devin Hartline, *Nimmer Changes His Tune: “Making Available” Is Distribution*, COPYHYPE (Oct. 2, 2012), <http://www.copyhype.com/2012/10/nimmer-changes-his-tune-making-available-is-distribution/> (“Several courts have consulted Nimmer on Copyright when analyzing whether ‘making available’ constitutes distribution. As recently as 2011, the treatise took the position that infringement of the distribution right requires actual dissemination of copies of a work to the public. But in the latest edition, Nimmer has changed his tune—the treatise now states that ‘making available’ is distribution *simpliciter*. After a detailed examination of the legislative history of the current Copyright Act, Nimmer now concludes that ‘the distribution right was formulated precisely so that it would extend to making copyrighted works available, rather than mandating proof of actual activities of distribution.’” (citations omitted)); Horsfield-Bradbury, *supra* note 105; Robert Kasinic, *Making Circumstantial Proof of Distribution Available*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1145, 1145 (2008).

<sup>112</sup> 2 M. B. NIMMER & D. NIMMER, *supra* note 61, § 8.11 [B][4][a].

1976 Act's right to "distribute," and at the same time expanding the definition "publication" to include offers to distribute.<sup>113</sup>

So rather than mine extant case law for the currently prevailing judicial viewpoints, the treatise purports to divine the intentions of Congress with respect to Internet postings and downloading in 2013 based on diffuse words and actions predating passage of the Copyright Act of 1976. After a lengthy (more than 10,000 words excluding footnotes) and didactic discussion of the issue's purportedly expansive history, the treatise states of the extant case law: "In sum, the courts have been divided."<sup>114</sup> This is followed by a handily bolded subheading for understandably skimming readers: "Conclusion: Making Works Available Via File-Sharing Implicates the Distribution Right," with appended text stating:

Going back to the seminal reports of the 1960s and applying them to the technologies of the 2010s cements the proposition that there is no need to show consummated acts of actual distribution. Instead, the intent of Congress was to incorporate a "make available" right into the copyright owner's arsenal.<sup>115</sup>

With these words Nimmer seeks to upgrade content owners' "arsenals" with a new copyright enforcing weapon that was divined via a "lost ark," and is now fixed in "cement." That is a startling move by what is ostensibly an interpretative guide, because it advocates significantly changing the balance of online copyright law in favor of copyright holders without any even vaguely contemporary signal from Congress or congruent ruling within the federal judiciary.

#### 4. Volition

Volition is an important concept in the Internet age.<sup>116</sup> A number of courts have held that a person or entity must engage in a volitional act of copying to be directly liable for infringement.<sup>117</sup> For example, in *Religious Technology Center v.*

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<sup>113</sup> *Id.* § 8.11 [D][1].

<sup>114</sup> 2 M. NIMMER & D. NIMMER, *supra* note 61, § 8.11 [C][1][b][3][a].

<sup>115</sup> *Id.* § 8.11 [D][4][c].

<sup>116</sup> See, e.g., Alfred C. Yen, *Internet Service Provider Liability for Subscriber Copyright Infringement, Enterprise Liability, and the First Amendment*, 88 GEO. L.J. 1833, 1833 (2000); Mark A. Lemley & R. Anthony Reese, *Reducing Digital Copyright Infringement without Restricting Innovation*, 56 STAN. L. REV. 1345, 1345 (2004).

<sup>117</sup> *Copyright: Infringement Issues*, INTERNET LAW TREATISE, [https://ilt.iff.org/index.php/Copyright:\\_Infringement\\_Issues](https://ilt.iff.org/index.php/Copyright:_Infringement_Issues) (last visited Nov. 17, 2013); *Religious Tech. Ctr. v. Netcom On-Line Commc'ns Servs., Inc.*, 907 F. Supp. 1361, 1370 (N.D. Cal. 1995) (holding an ISP serving as a passive conduit for copyrighted material not liable

*Netcom On-Line Communications Services*, the court held that an Internet Service Provider (ISP) serving as a passive conduit for copyrighted material is not liable as a direct infringer, reasoning that “[a]lthough copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant’s system is merely used to use a copy by a third party.”<sup>118</sup> David Nimmer’s assertion both professionally at conferences<sup>119</sup> and in the Nimmer treatise that copyright has no volition requirement at all is fairly controversial.<sup>120</sup> This view imposes upon ISPs such an extremely onerous duty to police the content moving through their clouds and servers that the burden could prove incapacitating to their very existence. One judge acerbically noted: “The distinguished commentator David Nimmer does not consider volitional conduct on the part of the defendant as a necessary element to establish direct infringement” before rejecting this view and determining that the passive processing of users’ uploads was unlikely to establish that Google had directly infringed copyrights.<sup>121</sup> Another commentator more colorfully

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as a direct infringer, and requiring a volitional act for a direct infringement claim: “Although copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant’s system is merely used to use a copy by a third party.”); *CoStar Grp., Inc. v. LoopNet, Inc.*, 373 F.3d 544, 555 (4th Cir. 2004) (“Agreeing with the analysis in *Netcom*, we hold that the automatic copying, storage, and transmission of copyrighted materials, when instigated by others, does not render an ISP strictly liable for copyright infringement under §§ 501 and 106 of the Copyright Act.”).

<sup>118</sup> *Religious Tech. Ctr.*, 907 F. Supp. at 1370.

<sup>119</sup> See, e.g., David Nimmer, *Brains and Other Paraphernalia of the Digital Age*, 10 Harv. J. L. & Tech. 1 (1996) (as presented by David Nimmer, Jan. 22, 1996 as part of a continuing education course); David Nimmer, Continuing Legal Education Course Materials, *The Visual Artists Rights Act of 1990*, C579 ALI-ABA 149 (Mar. 20, 1991). Cf. Plaintiff Perfect 10, Inc.’s Opposition to Defendant Megaupload Ltd.’s Motion to Dismiss at 15, *Perfect 10, Inc. v. Megaupload Ltd.*, No. 11CV0191-IEG(BLM), 2011 WL 3203117 (S.D. Cal., July 27, 2011), vacated by No. 11CV0191-IEG(BLM), 2011 WL 10618723 (S.D. Cal., Oct. 11, 2011); Answering Brief of Defendants—Appellees Amazon.com, Inc. and A9.com, Inc. at 28, *Perfect 10, Inc. v. Amazon.com, Inc.* 487 F.3d 701, amended and superseded by 508 F.3d 1146 (9th Cir. 2007); Elenor M. Lackman & Scott J. Sholder, *The Role of Volition in Evaluating Direct Copyright Infringement Claims Against Technology Providers*, 22 BRIGHT IDEAS Winter 2013 at 6, n.48.

<sup>120</sup> See Carrie Bodner, *Master Copies, Unique Copies and Volitional Conduct: Cartoon Network’s Implications for the Liability of Cyber Lockers*, 36 COLUM. J. L. & ARTS 491 (2013), available at [http://www.lawandarts.org/wp-content/uploads/2013/06/4-Bodner\\_post-format.pdf](http://www.lawandarts.org/wp-content/uploads/2013/06/4-Bodner_post-format.pdf); Mathew D. Lawless, *Against Search Engine Volition*, 8 ALB. L.J. SCI. & TECH. 205 (2008).

<sup>121</sup> *Perfect 10, Inc. v. Google, Inc.*, No. CV 04-9484 AHM (SHx), 2010 U.S. Dist. LEXIS 145449 at \*24, n.8 (C.D. Cal. July 30, 2010); see also *Parker v. Yahoo!, Inc.*, No. CV 07-2757, 2008 WL 4410095 (E.D. Pa. Sept. 25, 2008) (“Although copyright infringement generally operates under a theory of strict liability, various courts have required an additional element of ‘volition or causation’ to find direct infringement. E.g., *CoStar Group, Inc. v. LoopNet, Inc.*, 373 F.3d 544, 549 (4th Cir. 2004); *Religious Tech. Ctr. v. Netcom On-Line Comm’n Servs.*, 907 F. Supp. 1361, 1372 (N.D. Cal. 1995). But see [3 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT, *supra* note 44,



observed: “This makes me want to post pirated content on David Nimmer’s site without his knowledge, just to see if he’ll give in and pay statutory damages.”<sup>122</sup>

### 5. Preliminary Injunctions and the Presumption of Irreparable Harm

Injunctive relief is a powerful tool which can end infringing behavior quickly, but also cause harms of its own.<sup>123</sup> Professor Pamela Samuelson wrote in 2010:

It has become lamentably common for courts to issue preliminary injunctions in copyright cases once rights holders have shown a reasonable likelihood of success on the merits without going on to require them to prove that they will suffer irreparable harm unless the injunction is issued. Harm is too often presumed to be irreparable if plaintiffs have made out a prima facie case of infringement. This presumption cannot be squared with traditional principles of equity, as interpreted in numerous Supreme Court decisions.<sup>124</sup>

Large scale content owners benefitted greatly from a “presumption of irreparable harm” jurisprudential approach to preliminary injunctions that made them easy to obtain by copyright holders, an approach the Nimmer treatise heartily endorsed.<sup>125</sup> After the Supreme Court’s ruling in a patent law case, *eBay v. Merc Exchange*, made the “presumption of irreparable harm” position analytically untenable in the copyright context, one judge expressly noted the impact this had on the Nimmer treatise, writing:

Before *eBay*, *Nimmer on Copyright* was routinely cited as supporting the presumption. See *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d at 1254 (citing 3 *Nimmer on Copyright* § 14.06[A], at 14–50, 14–51 & n.16 (collecting authorities)). *Nimmer* has now seen the light, and recognizes that even in the context of preliminary injunctions in a copyright infringement claim, “[t]he Supreme Court’s decision in *eBay* caused a new day to dawn . . . . No longer applicable is the presumption of irreparable harm, which allowed the collapse of factors that plaintiff must prove down to one. As one commentator notes,

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§ 12B.06[B][2][c][iii]] (arguing that the text and legislative history of the Copyright Act show that volition is only one of several considerations and not a decisive factor).”).

<sup>122</sup> E-mail from Anonymous Professor to Author (on file with author).

<sup>123</sup> Pamela Samuelson & Krzysztof Bebenek, *Why Plaintiffs Should Have to Prove Irreparable Harm in Copyright Preliminary Injunction Cases*, 6 ISJLP 67 (2010); K.J. Greene, *Motion Picture Copyright Infringement and the Presumption of Irreparable Harm*, 31 RUTGERS L.J. 173 (2000).

<sup>124</sup> Samuelson & Bebenek, *supra* note 123.

<sup>125</sup> 4 NIMMER, *supra* note 56, § 14.06 [A][2][b] & n.16 (“A copyright plaintiff who makes out a prima facie case of infringement is entitled to a preliminary injunction without a detailed showing of irreparable harm.”).

‘Harm must be proved, not presumed.’” 4 *Nimmer on Copyright* § 14.06[A][5], at 14–149 (footnotes omitted).<sup>126</sup>

What is remarkable about the preliminary injunctions section of the current edition of the Nimmer treatise is not that it correctly reports the law, but that it buries its discussion of the *eBay* decision so deeply. The reader has to plow through numerous confusing paragraphs like this:

Many cases state “the prevailing view that a showing of a prima facie case of copyright infringement, or reasonable likelihood of success on the merits, raises a presumption of irreparable harm.” Pursuant to that approach, under the predominant test set forth above, the plaintiff’s burden for obtaining a preliminary injunction in copyright cases reduces to showing likelihood of success on the merits, without a detailed showing of danger of irreparable harm. As the Second Circuit observed, “Since defendant sells essentially the same product as plaintiff to the same market, it will obviously suffer considerable loss if defendant disseminates its prayerbook, because each sale of defendant’s prayerbook probably results in one less sale of plaintiff’s prayerbook.” The harm in that case was apparent, given that the primary market for the product was synagogues, which “have no use for two separate prayerbooks.”<sup>127</sup>

Much later in the section on remedies the Nimmer treatise finally notes:

*eBay v. MercExchange* dealt with a permanent injunction under the Patent Act. Subsequent rulings have applied it to preliminary injunctions under the Patent Act. Given that the Court reached its ruling by noting that “this Court has consistently rejected invitations to replace traditional equitable considerations with a rule that an injunction automatically follows a determination that a copyright has been infringed,” it only makes sense to apply it to the instant domain of enjoining copyright infringement as well. After all, if discretion attends the determination of whether to enjoin defendants whose cases have been adversely adjudicated to completion, it follows *a fortiori* that district courts may exercise their discretion to withhold injunctive relief pending trial when the ultimate disposition remains uncertain, even given a strong *likelihood* of success on the merits.

Accordingly, *eBay* occasions re-evaluation of the standards previously articulated for issuance of preliminary injunctions. The predominant test invokes only two factors, which collapse into one. More consonant with the four factors mandated under *eBay* are the four factors of the variant test noted above. Of course, given that the Court in *eBay* was addressing the remedy after a finding of liability,

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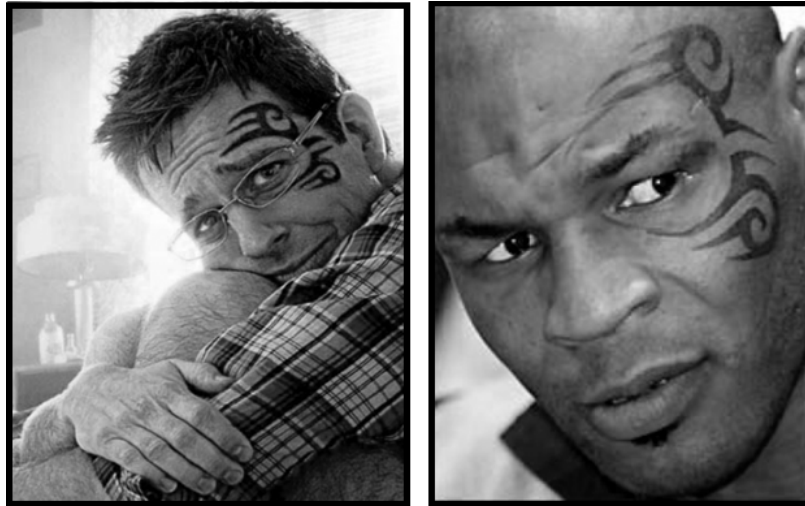
<sup>126</sup> Flexible Lifeline Systems, Inc. v. Precision Lift, Inc., 654 F.3d 989, 999-1000 (9th Cir. 2011).

<sup>127</sup> 5 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 14.06 [A][2][b] (Matthew Bender, rev. ed. 2013).

it did not refer to the “likelihood of success.” In the context of a preliminary injunction, that consideration is obviously at the forefront of the court’s determination, under every formulation. Accordingly, the variant test quoted above best sets out the four factors that would seem to govern at present.<sup>128</sup>

And it still is not until many subsections later that Nimmer’s “[t]he Supreme Court’s decision in *eBay* caused a new day to dawn” comment cited by the court finally surfaces.<sup>129</sup> Anyone looking to the Nimmer treatise for a clear statement of the current standard for obtaining preliminary injunctions in copyright infringement cases is likely to be sorely disappointed, and possibly also deeply confused. An admirer of the Nimmer treatise recently wrote that it adopts “a classic Socratic method of legal writing.”<sup>130</sup> Not everyone seeking answers within it will consider that an advantage.

C. *An Illustrated Illustration of Everything that is Wrong with Allowing the Nimmer Treatise to Drive Copyright Law: A Tale of Two Tattoos*<sup>131</sup>



<sup>128</sup> *Id.* § 14.06 [A][3][a].

<sup>129</sup> *Id.* § 14.06 [A][5][a][i].

<sup>130</sup> Field, *supra* note 62 (“In Nimmer on Copyright, everything is questioned, everything is examined, and nothing is taken at face value without thorough research, analysis, and context. Question marks abound in the text, followed by thorough answers. This classic Socratic method of legal writing informs the overall structure of the treatise via sub-sections whose title announces their purpose to offer criticism of a doctrine, or examination of the rationale behind the law.”).

<sup>131</sup> The images below were taken from the publicly filed complaint in the case *Whitmill v. Warner Brothers Entertainment*. Complaint at 5, *Whitmill v. Warner Bros. Entm’t*, No. 4:11-cv-752 (E.D. Mo. Apr. 28, 2011), ECF No. 1, available at <http://www.nytimes.com/interactive/2011/05/21/business/media/20110521tattoo-case.html>.

In 2011 tattoo artist Victor Whitmill was distressed to learn that a tattoo he created for the face of former boxer Mike Tyson was being used on the face of a character in the movie *Hangover II* without his permission.<sup>132</sup> He believed that Warner Brothers Entertainment, Inc., the producer of *Hangover II*, was infringing his copyright in the tattoo by reproducing and using it without licensing the rights, so he hired an attorney and commenced litigation.<sup>133</sup> One reporter observed:

Plaintiff and tattoo artist S. Victor Whitmill filed the instant lawsuit in April, asserting copyright infringement in connection with a fake tattoo drawn on the face of actor Ed Helms in the film. The tattoo is nearly identical to the real life tattoo created by Whitmill for former world heavyweight champion boxer Mike Tyson, who also appears in the film. Whitmill asserts that when he created the original tattoo for Tyson, Tyson agreed Whitmill would own all relevant artwork and copyright associated with the design.

For Mr. Whitmill, this case is not about Mike Tyson, Mike Tyson's likeness, or Mike Tyson's right to use or control his identity. This case is about Warner Bros. appropriation of Mr. Whitmill's art and Warner Bros. unauthorized use of that art, separate and apart from Mr. Tyson. Not only is this infringing copy (the "Pirated Tattoo") used throughout the movie, but Warner Bros. also uses the Pirated Tattoo extensively in advertisements and promotions without Mr. Tyson. This unauthorized exploitation of the Original Tattoo constitutes copyright infringement," Whitmill asserted in his complaint.<sup>134</sup>

The disputed tattoo was used extensively in the advertising campaign for the movie, licensed 7-Eleven promotional tie-ins, and in an iPhone app.<sup>135</sup> Whitmill characterized it as a "central plot device,"<sup>136</sup> and its importance to the movie was acknowledged by Warner Brothers in its pleadings, which admitted that the tattoo appeared in its significant promotional campaign for the film.<sup>137</sup>

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<sup>132</sup> Complaint ¶ 1, *Whitmill v. Warner Bros. Entm't*, No. 4:11-cv-752 (E.D. Mo. Apr. 28, 2011), ECF No. 1, *available at* <http://www.nytimes.com/interactive/2011/05/21/business/media/20110521tattoo-case.html>.

<sup>133</sup> *See id.*

<sup>134</sup> *Mo. Federal Judge Denies Injunction in 'Hangover 2' Copyright Dispute*, 10-5 MEALEY'S LITIG. REP. COPYRIGHT (June 6, 2011); *see also* Verified Complaint for Injunctive and Other Relief at 1, *Whitmill v. Warner Bros. Entm't*, No. 4:11-cv-752 (E.D. Mo. May 20, 2011) (alteration in original).

<sup>135</sup> Plaintiff's Reply Memorandum in Support of His Motion for Preliminary Injunction at 2, *Whitmill v. Warner Bros. Entm't*, No. 4:11-cv-752 (E.D. Mo. May 20, 2011).

<sup>136</sup> *Id.*

<sup>137</sup> *See* Warner Bros.' Memorandum in Opposition to Plaintiff's Motion for Preliminary Injunction, *Whitmill v. Warner Bros. Entm't*, No. 4:11-cv-752 (E.D. Mo. May 20, 2011).

Warner Brothers Entertainment, which produced the movie, often takes a self-serving position in favor of strong copyright protections, lobbying Congress and advocating for cultural “respect for copyrights”<sup>138</sup> through the Motion Picture Association of America<sup>139</sup> in partnership with other large movie companies. So when Mr. Whitmill brought a copyright infringement suit against it, one imagines Warner Brothers’s attorneys might have been fairly enthusiastic about taking a position in defense of the infringement charges that did not make Warner Brothers look stunningly hypocritical on the issue of unauthorized copying. The position they adopted was that tattoos were simply not copyrightable subject matter. Because no tattoo could correctly be copyright protected, this argument averred, there was no copyright that could be infringed when the tattoo at issue was copied.

Warner Brothers Entertainment had a big problem, however, and that problem was volume three of Nimmer’s Treatise, which referenced within its pages a copyright case about tattoos, *Owens v. Ink Wizard Tattoos*.<sup>140</sup> At the time, footnote 392 of this section of the Nimmer treatise said:

More questionable, however, was its later statement that no “remedy at law would prevent the Owens from photocopying distributing and using the flash . . .” For a tattoo may presumably qualify as a work of graphic art, regardless of the medium in which it is designed to be affixed (in this instance, human flesh).<sup>141</sup>

Next, Warner Brothers Entertainment hired David Nimmer as an expert witness for the litigation,<sup>142</sup> most likely with the hope that he would recant this position in favor of the copyrightability of tattoos ascribed to him for approximately 11 years as author of his treatise. Recant he did, writing in a declaration that Warner Brothers Entertainment somehow passed off as admissible evidence:

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<sup>138</sup> *Content Protection*, MPAA, <http://www.mpaa.org/contentprotection> (last visited Oct. 2, 2013).

<sup>139</sup> *About Us*, MPAA, <http://www.mpaa.org/about> (last visited Oct. 2, 2013).

<sup>140</sup> 1 M. NIMMER & D. NIMMER, *supra* note 32, § 1.01 [B][1][i] n.392 (citing *Owens et al. v. Ink Wizard Tattoos*, 533 S.E.2d 722, 724 (Ga. 2000)).

<sup>141</sup> See E-mail from Neil Myers, Lexisnexis employee and editor of the Nimmer treatise, to Cynthia Pittson, Professor of Law, Pace Law School (May 23, 2013) (on file with author).

<sup>142</sup> Decl. of David Nimmer at ¶ 2, *Whitmill v. Warner Bros. Entm’t*, No. 4:11-cv-752 (E.D. Mo. May 20, 2011), ECF No. 29-6 (“Warner Bros. Entertainment Inc. has retained my services, through Irell & Manella LLP, in connection with the above-captioned case.”).

In years past, I tacitly assumed that a tattoo could “presumably qualify as a work of graphic art, regardless of the medium in which it is designed to be affixed” such as “human flesh.” In writing up a 2000 case, I even posited one line to that effect in a footnote, without purporting to cite any authority in support. See 1 Nimmer on Copyright Section 1.01[B][1][i]n.392.<sup>143</sup>

Nimmer’s declaration is noticeably vague about during which years or for how many years his treatise expressly asserted that tattoos were copyrightable. He alludes to “writing up a 2000 case” to imply that it was in the year 2000 that he “posited” that tattoos were copyrightable.<sup>144</sup> Elsewhere in the declaration he says that he had a change of heart in 2001, writing:

*About a decade ago, in composing a book-length treatment of copyright subsistence, I began to reconsider that proposition. In sketching out a score of different cases, I formulated one to consider whether a human body may ever qualify as the requisite “medium of expression” to secure copyright protection. After first ruminating that a court faced with such a claim should “dismiss it summarily, if on no other basis than the constitutional prohibition on involuntary servitude and other badges of slavery,” I concluded that “a body, even as augmented, simply is not subject to copyright protection.”*<sup>145</sup>

What Nimmer glaringly neglects to mention is that he wrote these words in 2001 about copyright claims a plastic surgeon might make with respect to the entire body of a patient, not a tattoo. Far more problematic, however, is the impression he creates about the timeline of his views. He mentions “writing up a 2000 case” as a platform for positing that tattoos are copyrightable, and then writing a law review article in 2001 reflecting a change of heart. The reader is encouraged to assume that he simply neglected to update his treatise on this matter in the intervening decade. One might be very surprised to learn, then, that the version of Footnote 392 endorsing the copyrightability of tattoos was not added to the treatise until 2007! Nimmer may have been “writing up a 2000 case” when he authored that version of the footnote, but he did not publish it until 2007, six years after his supposed change of heart on the matter referenced in his declaration.<sup>146</sup>

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<sup>143</sup> See *id.* ¶ 15.

<sup>144</sup> *Id.*

<sup>145</sup> *Id.* ¶ 16 (emphasis added).

<sup>146</sup> E-mail from Neil Myers, *supra* note 141.

Dear Cynthia,

I think that I can be of some help here. We do not have records going back to 2000, but I can trace this particular footnote back to its inception.

The December 2008 and August 2010 versions of the treatise retained Nimmer's endorsement of copyrightability of tattoos.<sup>147</sup> By the time the declaration was submitted to the court, however, the online version of the Nimmer treatise may already have been sanitized to suit his new position. No later than December of 2011, paper version updates were issued in which the footnote he referenced, n.392, was quietly altered to read: "More questionable, however, was its later statement that no 'remedy at law would prevent the Owenses from photocopying distributing and using the flash . . . . For the image may presumably qualify as a work of graphic art.'"<sup>148</sup> Neither the

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Section 1.01[B][1][i], then entitled "Conversion and Trespass," was split and completely revised in Release 73 (August 2007). *Owens v. Ink Wizard Tattoos* did not appear in the earlier coverage; it was added in footnote 392 as part of the 2007 revision. I have attached a PDF file setting out the text of text of former subsection [i] as it appeared before the revision.

As updated in Release 73 (August 2007), new footnote 392 read as follows (see attached PDF):

<sup>392</sup>533 S.E.2d at 724. More questionable, however, was its later statement that no "remedy at law would prevent the Owenses from photocopying distributing and using the flash . . ." *Id.* at 724. For a tattoo may presumably qualify as a work of graphic art, regardless of the medium in which it is designed to be affixed (in this instance, human flesh). See § 2.08[B][3] *infra*.

In Release 86 (December 2011), footnote 392 was revised again to read as you see it today (also in the attached PDF):

<sup>392</sup>533 S.E.2d at 724. More questionable, however, was its later statement that no "remedy at law would prevent the Owenses from photocopying distributing and using the flash . . ." *Id.* at 724. For the image may presumably qualify as a work of graphic art. See § 2.08[B][3] *infra*.

I hope that this is useful to you.

Neil

<sup>147</sup> Copies on file with author and with the *Brooklyn Law Review*.

<sup>148</sup> 1 M. NIMMER & D. NIMMER, *supra* note 32, § 1.01 [B][1][i] n.392. Later in the same section, Nimmer states:

Allegations of conversion can arise in a myriad of settings. One case held pre-empted claims of conversion and unjust enrichment for defendant airline's use of computer macros that plaintiff authored. An architect was aggrieved when his plans were used to construct a building; the court upheld his breach of contract count, but dismissed the conversion claim as pre-empted. If the complaint is for licensing of photographs, it could be pre-empted; but if for return of wrongfully retained original chromes, it is not. In one case, the alleged conversion was of "flash," namely "pre-printed tattoo designs which a customer views and chooses from in deciding what design to have placed on the customer's body." Given that such flash consists of a tangible work, the Georgia Supreme Court was correct to allow the conversion cause of action to proceed on the basis that "Mr. Owens stole the flash."

deletion of the words “regardless of the medium in which it is designed to be affixed (in this instance, human flesh)” nor the reason for the edit is noted, and if one had not been aware of the previous iteration of n.392 for external reasons, there would be no way to know the leading treatise on copyright law was now leading readers in an alternative direction.

Not content to simply refer to an express statement as a “tacit assumption,” Nimmer walked back his actual expressed words by invoking rather histrionic analogies. First he declared that if the tattoo was deemed to qualify for protection under the Visual Artists Rights Act (an unlikely possibility at best, to put it lightly<sup>149</sup>), copyright law “thereby becomes the instrument to impose, almost literally, *a badge of involuntary servitude, akin to the mark with which ranchers brand the cattle they own.*”<sup>150</sup> It sounds as if he is saying that by freely choosing to have Whitmill fix the tattoo of his choosing to his face, Mike Tyson ceded some sort of ownership interest in his body to Whitmill, enforced by copyright law. Lest that be too subtle, a few sentences later, Nimmer declares:

If Mr. Tyson chooses to obtain an adjacent or overlapping tattoo on his face, he will have compromised the copyright owner’s right to prepare derivative works, thereby becoming a copyright infringer. As such, he is subject to a court order that the offending work be destroyed. A court that vindicates Mr. Whitmill’s statutory rights by ordering laser removal of the unauthorized product has allowed the Copyright Act to be perverted, once again, into an instrument rendering Mr. Tyson into a virtual slave.<sup>151</sup>

Nimmer’s invocations of involuntary servitude (referenced in the Thirteenth Amendment to the U.S. Constitution,<sup>152</sup> and more contemporarily within the criminal code’s prohibitions on human trafficking<sup>153</sup>), of branding (which was routinely imposed upon slaves in the United States before the Emancipation

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*Id.* § 1.01 [B][1][i] (citations omitted); *see also* SHARON FORSCHER, THE VISUAL ARTISTS RIGHTS ACT OF 1990 (Philadelphia Volunteer Lawyers for the Arts, 2008), *available at* <http://www.artsandbusinessphila.org/pvla/documents/VisualArtistsAct.pdf>.

<sup>149</sup> *See, e.g.*, Cynthia Esworthy, *From Monty Python to Leona Hemsley: A Guide to the Visual Artists Rights Act*, *available at* [http://www.law.harvard.edu/faculty/martin/art\\_law/esworthy.htm](http://www.law.harvard.edu/faculty/martin/art_law/esworthy.htm).

<sup>150</sup> Decl. of David Nimmer, *supra* note 142, ¶ 20(a) (emphasis added).

<sup>151</sup> *Id.* ¶ 20(b) (citations omitted) (emphasis added).

<sup>152</sup> U.S. CONST. amend. XIII, § 1.

<sup>153</sup> *Involuntary Servitude, Forced Labor, and Sex Trafficking Statutes Enforced*, U.S. DEPT. OF JUSTICE, <http://www.justice.gov/crt/about/crm/1581fin.php> (last visited Oct. 7, 2013).



Proclamation and Thirteenth Amendment freed them<sup>154</sup>) and of virtual slavery when discussing a tattoo freely chosen by an African American celebrity are rather shocking. I'm inclined to agree with David Nimmer's assertions in his affidavit that certain mechanisms of copyright enforcement, already troubling from a personal property perspective when applied to the owner of copyrighted painting, would be excessively harsh if applied to a human face. Unlike David Nimmer, though, I credit judges with the ability to enforce copyright protections in a manner that does not force people into involuntary servitude or virtual slavery.<sup>155</sup> Professor Douglas Lichtman was also unpersuaded by Nimmer's arguments in this matter, writing:

I find Nimmer's declaration shockingly unconvincing. Had Nimmer argued that Warner Brothers' use of the tattoo is fair use, he might very well have had me on his side. Had he argued that certain copyright remedies are off the table in instances when some otherwise-traditional remedy would (if applied here) constrain significant personal freedoms like the freedom to show one's own face in public, fine. But Nimmer argued that the tattoo is not eligible for protection because it is not "fixed in a tangible medium of expression" and thus fell short of a threshold requirement that is codified in Section 102(a) of the Copyright Act. That makes no sense.<sup>156</sup>

Some observers found it astonishing that David Nimmer's declaration was even admitted into evidence, given that it contains legal arguments, not assertions of fact, and what Nimmer says is therefore not "evidence." Attorney C.E. Petit noted:

Perhaps Professor Bartow herself is too polite to note it; perhaps she is a bit too removed from practice to have noticed it; but I found yet another ridiculous aspect of Professor Nimmer's change of opinion: It's in an improper document *that the court should never have*

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<sup>154</sup> Frederick Douglass, *The Horrors of Slavery and England's Duty to Free the Bondsman*, in THE FREDERICK DOUGLASS PAPERS 371 (1979), available at <http://www.yale.edu/glc/archive/1081.htm>; Leonard J. Hoenig, *The Branding of African American Slaves*, 148 JAMA DERMATOLOGY, Feb. 2012; *The Growth of Slavery in North America*, PBS ONLINE <http://www.pbs.org/wgbh/aia/part1/1narr5.html> (last visited Nov. 17, 2013); REV. THEODORE DWIGHT WELD ET AL., AMERICAN SLAVERY AS IT IS: TESTIMONY OF A THOUSAND WITNESSES 21 (1839), available at <http://medicolegal.tripod.com/weldslaveryasis.htm#p21-branded>; *Branding Iron*, UNDERSTANDING SLAVERY INITIATIVE, [http://understandingslavery.com/index.php?option=com\\_content&view=article&id=622:branding-iron&catid=146&Itemid=256](http://understandingslavery.com/index.php?option=com_content&view=article&id=622:branding-iron&catid=146&Itemid=256) (last visited Nov. 20, 2013).

<sup>155</sup> For a detailed discussion of the legal issues involved in copyrighting tattoos, see Yolanda M. King, *The Challenges "Facing" Copyright Protection for Tattoos*, 92 OR. L. REV. 129 (2013).

<sup>156</sup> Douglas Lichtman, *Are Tattoos Eligible for Copyright Protection?*, THE MEDIA INSTITUTE (June 15, 2011), <http://www.mediainstitute.org/IP/2011/061511.php>.

*allowed to be filed.* An expert opinion may only “assist the *trier of fact* to understand the evidence or to determine a fact in issue” (Fed. R. Evid 702, emphasis added). Arguments about the law are for the lawyers and to the judge only; if one wishes to bring in material from a “legal expert,” the proper method to do so is via citation to legal authority. There’s nothing wrong with that citation being to a yet-to-be-published work—so long as one provides copies to both the judge and the other side—but putting an interpretation of *legal doctrine* in as an “expert opinion” is flat wrong. Another big LA law firm tried this BS in the *Ellison* matter to no avail. You’d think they’d learn that if they’re going to tell the judge what the law is, they should do so in the context of telling the judge what the law is.<sup>157</sup>

The judge did at least, to her credit, ultimately decline to allow David Nimmer to testify, despite Warner Brothers’ assertion that “Professor Nimmer’s testimony about this very obscure and novel issue of copyright law on which he is clearly an expert [would] be helpful to the Court.”<sup>158</sup> Nor was she persuaded by his affidavit, describing his arguments as “just silly” in her ruling on the preliminary injunction motion, where the judge wrote:

If I look at the likelihood of success on the merits, I think plaintiff has a strong likelihood of prevailing on the merits for copyright infringement.

Most of the defendant’s arguments against this are just silly. Of course tattoos can be copyrighted. I don’t think there is any reasonable dispute about that. They are not copyrighting Mr. Tyson’s face, or restricting Mr. Tyson’s use of his own face, as the defendant argues, or saying that someone who has a tattoo can’t remove the tattoo or change it, but the tattoo itself and the design itself can be copyrighted, and I think it’s entirely consistent with the copyright law, and after all, in this case, Mr. Whitmill and Mr. Tyson did have a contract dealing with this issue, which is totally consistent and appropriate under copyright law.<sup>159</sup>

Unsurprisingly, the case settled soon afterward.<sup>160</sup> There is an odd coda to this case, though, related to the official transcripts. Although the transcript of the preliminary injunction hearing was initially a matter of public record, Warner Brothers successfully

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<sup>157</sup> *A Matter of Internet and Symbolism*, SCRIVENER’S ERROR (May 30, 2011, 2:15 PM), <http://scrivenserror.blogspot.com/2011/05/b530x.html> (emphasis in original).

<sup>158</sup> Transcript of Preliminary Injunction Hearing at 58, *Whitmill v. Warner Bros. Entm’t*, No. 4:11-cv-752 (E.D. Mo. May 23, 2011).

<sup>159</sup> Transcript of Hearing on Motion for Preliminary Injunction II at 3, *Whitmill v. Warner Bros. Entm’t*, No. 4:11-cv-752 (E.D. Mo. May 24, 2011).

<sup>160</sup> Justin Tenuto, *Warner Bros. Settles Tyson Tattoo Case Over Hangover II*, ARTICLE3 (June 21, 2011), <http://www.article-3.com/warner-bros-settles-tyson-tattoo-case-over-hangover-ii-92253>.

petitioned the court to retroactively place it under seal, and now the only publicly available transcript is a redacted one.

### III. A RESTATEMENT OF COPYRIGHT WOULD BE A BETTER TREATISE

I wholeheartedly agree with Copyright Register Pallante about the need for copyright law reform, and would add that it is time for a new leading treatise. That new treatise should take the form of a *Restatement of Copyright Law*.

#### A. *It Would Be Better Than Any Treatise Produced by a Sole Author*

Ideally the Restatement would explain the settled aspects of copyright law in as neutral and coherent a fashion as possible. It would chart gaps and shifts within the law, and indicate when an author is stating her own prediction or recommendation at clear interstices, leaving room for a visible, measured debate about contested points of law whenever practicable. Perhaps at times there would be pitched battles within its pages, written debates about doctrinal disputes accessible to every reader. On other matters a clear consensus would prevail and inform. An ALI committee could ensure that all this happened more effectively than any individual. A *Restatement of Copyright Law* could provide a competing source of useful and well-organized information to courts, lawyers, and anyone else who is slavishly following and citing a particular copyright treatise due to either a lack of reflection or a lack of options. Such a Restatement offers the tantalizing possibility of a less biased, and more balanced exposition of copyright law than is currently available, and one that is born authoritative because it is imbued with the gravitas of the ALI. This in turn might lead to improved understandings of copyright law issues, and therefore better (or at least better informed) judicial decision making.

This is not to suggest that the ALI process is perfect. In his article “When the Restatement is Not a Restatement” David Logan, adviser for the *Restatement (Third) of Torts*, wrote:

The handling of flagrant trespassers thus lays bare the core tension that exists in the very DNA of the elite and undemocratic ALI: whether it should be a force for bold law reform or [ ] merely a tidier

of messy common law doctrine, whether it should stake out “what law should be” rather than merely stating “what the law is.”<sup>161</sup>

Admittedly, the shape of ALI projects can be determined to a large extent by the views of the people willing to step up and do the work. Members who are the most enthusiastic about attending and participating in consultative meetings may have strong motivations that could build into a *Restatement of Copyright Law* some of the same problems raised here about currently existing treatises. Certainly the history surrounding the failed ALI UCC Article 2B initiative in the late 1990s can be viewed as a cautionary tale.<sup>162</sup> On the other hand, the ugliness and strife surrounding it were at least on the record and well known to the various stakeholders, as is illustrated below.

The ALI has recently been accused of being unduly influenced by the tobacco industry, and of having inadequate conflict of interest policies.<sup>163</sup> In response, ALI President Roberta Ramo and ALI Director Lance Liebman asserted:

The legal scholars who serve as Reporters on ALI projects receive comments and criticisms from many sources, in large and small meetings, by letter, and in emails. The ALI Archives at the University of Pennsylvania Law Library, open to all, contain drafts, notes, and comments that reveal how our projects and our resulting recommendations for improving the law evolve. Our Advisers, Members Consultative Groups, Council, and full Membership, through debate, motions, and votes, decide what ALI's recommendations to judges and legislatures will be. No one is disenfranchised or muzzled, nor should they be.

An ALI rule tells members to “leave our clients at the door,” and it is a point of honor among members that we state what we personally believe to be right, not what our clients want us to say. But it is equally important that we make certain that all significant points of view are represented and explained. New Restatement work is always underway, identifying imperfections in earlier versions,

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<sup>161</sup> David A. Logan, *When the Restatement Is Not a Restatement: The Curious Case of the “Flagrant Trespasser,”* 37 WM. MITCHELL L. REV. 1448, 1483 (2011).

<sup>162</sup> See e.g. Cem Kaner, *Uniform Commercial Code Article 2B: A New Law of Software Quality*, BAD SOFTWARE (Nov. 10, 1997), <http://www.badsoftware.com/uccsqa.htm>; Pamela Samuelson & Kurt Opsahl, *Licensing Information in the Global Information Market: Freedom of Contract Meets Public Policy*, BERKELEYLAW (May 31, 2002), <http://people.ischool.berkeley.edu/~pam/papers/2bEIPR.pdf>; Llewellyn Joseph Gibbons, *Stop Mucking Up Copyright Law: A Proposal for a Federal Common Law of Contract*, 35 RUTGERS L. J. 959 (2004); Caroline Edwards, *Article 2 of the Uniform Commercial Code and Consumer Protection: The Refusal to Experiment*, 78 ST. JOHN'S L. REV. 663 (2004).

<sup>163</sup> Elizabeth Laposata et al., *Tobacco Industry Influence on the American Law Institute's Restatement of Torts and Implications for Its Conflict of Interest Policies* 98 IOWA L. REV. 1 (2012).

responding to new information and evidence, and seeking legal doctrine that fits contemporary values.<sup>164</sup>

Assuming this is accurate, it sounds like a process likely to produce a more useful and effective copyright treatise than any individual would ever be capable of, as a matter of scalable resources, if nothing else. However, it needs to be noted that in surrebuttal the ALI tobacco bias accusers maintained:

The ALI response ignored the core conclusions of our paper: (1) the ALI allowed its work to be secretly manipulated by the tobacco industry in large part because of the ALI's lack of strict conflict of interest policies, and (2) policy makers should not rely on ALI works until the ALI implements modern conflict of interest procedures.

The tobacco industry documents that led to these conclusions speak for themselves. The ALI did not dispute either the substance of these conclusions or the validity of the documentary evidence we presented to support them, nor did it offer any evidence in rebuttal of the case we presented.

We compared the ALI's conflict of interest policies to the National Academies' because both organizations create works that provide scholarly advice to policy makers, while purporting to be based on a neutral reading of the evidence. In stark contrast to the ALI, the National Academies have strict conflict of interest policies that reflect the reality that even the most talented scientists, engineers, and physicians are still human beings, and it may be difficult for them to "leave [their] clients at the door."

Far from misunderstanding the processes that the ALI uses to produce the Restatements, we presented extensive documentary evidence that the tobacco industry *circumvented* those processes and held a backroom meeting with the Reporter for the Restatement (Second) of Torts. This backroom meeting was followed by industry-sought changes to the Restatement that effectively shielded the tobacco industry from liability for the death and disease suffered by its customers for decades.<sup>165</sup>

The authors further claimed that

the Reporter for the Restatement (Second) of Torts met secretly with tobacco industry lawyers and did their bidding; that tobacco industry lawyers had off-the-record access to key figures in the drafting of the Restatement (Third) of Torts, resulting in changes the tobacco

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<sup>164</sup> Roberta Cooper Ramo & Lance Liebman, *The ALI's Response to the Center for Tobacco Control Research & Education*, 98 IOWA L. REV. BULLETIN 1 (Jan. 19, 2013).

<sup>165</sup> Elizabeth Laposata et al., *Authors' Reply: The ALI Needs to Implement Modern Conflict of Interest Policies*, 98 IOWA L. REV. BULLETIN 17, 17-18 (Feb. 21, 2013).

industry sought; and that Victor Schwartz billed Philip Morris for his time as an ALI Advisor.<sup>166</sup>

These are certainly alarming allegations. One hopes that in the wake of them, the ALI will act energetically to reduce the likelihood of similar problems in the future. But even if they do not, it still strikes me as far harder to corrupt a Restatement process than it is to unduly influence a single treatise author.

*B. It Would Solve the Problem of Invisible Changes and Disappearing Law*

The disappearance of source materials is a pernicious problem.<sup>167</sup> When a treatise changes, there may not be any evidence whatsoever within its pages. As described above, after David Nimmer was hired by Warner Brothers in the Whitmill “Hangover 2 Tattoo” case, he changed footnote 392 in the Nimmer Treatise without leaving a notation. It is difficult and onerous, even with the assistance of competent and experienced law librarians, to reconstruct the evolution of any particular point of law through the various iterations of the Nimmer treatise. And one usually cannot confidently pin down that exact date of the change. If lawyers or judges did not know there had been a change, there is nothing in the treatise to inform them about it. Nor is there any way to anticipate when a change is imminent.

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<sup>166</sup> *Id.* at 18-19; see also Sglantz, *American Law Institute Tries to Sidestep Conflict of Interest Problems We Documented in Its Dealings With the Tobacco Industry*, CENTER TOBACCO CONTROL RES. & EDUC. (Feb. 24, 2013 11:08 PM), <http://tobacco.ucsf.edu/american-law-institute-tries-sidestep-conflict-interest-problems-we-documented-its-dealings-tobacco>.

Mining the millions of documents in the Legacy Tobacco Library [Laposata et al.] learned that tobacco industry lawyers working with their industry clients succeeded in modifying the draft Restatement to protect the tobacco industry from lawsuits. A prime actor was Covington & Burling partner and tobacco industry defense architect H. Thomas Austern who arranged a December 1961 meeting between tort law giant William L. Prosser and the Committee on Legal Affairs of the now notorious Tobacco Institute. The “good tobacco” language soon entered the draft, helping to insulate the industry from tort liability . . . .

Georgeconk, *Tobacco Industry Lawyers Influence on the Restatement of Torts*, PROFESSIONAL RESPONSIBILITY: A CONTEMPORARY APPROACH (Nov. 9, 2012), <http://contemporaryprofessionalresponsibility.com/2012/11/09/tobacco-industry-lawyers-influence-on-the-restatement-of-torts/> (citing Laposata et al., *supra* note 163).

<sup>167</sup> Scott McLemee, *In Search of the Missing Link*, INSIDE HIGHER ED (July 24, 2013), <http://www.insidehighered.com/views/2013/07/24/essay-link-rot>.

Recently a legal scholar was trying to confirm the accuracy of a citation to the Nimmer treatise made in *Summit Technology, Inc. v. High-Line Medical Instruments Co.*, in which Nimmer was quoted as stating “it is accurate to state that the Copyright Act bars the importation of gray market goods.”<sup>168</sup> After all other research avenues proved fruitless, a direct appeal was made to the treatise publisher, which garnered this reply:

In 2011, § 8.12 was substantially revised, and its footnotes renumbered. Former footnote 104 in that section is now footnote 363. Today, that footnote reads as follows:

See *Quality King Distribs., Inc. v. L’Anza Research Int’l, Inc.* 523 U.S. 135, 118 S. Ct. 1125, 140 L. Ed. 2d 254 (1998). To the extent that it accords a first-sale defense to imported items, that case rejects *Scorpio*. But its holding is arguably limited to the reimportation of goods initially manufactured in the United States, as will be discussed below, and thus can be read as harmonizing with *Scorpio*’s importation bar on goods manufactured and initially sold abroad. See § 8.12[B][6][c] *infra*.

Tracking footnote 104 backwards, before 2011 the footnote read substantially the same:

See *Quality King Distribs., Inc. v. L’Anza Research Int’l, Inc.* 523 U.S. 135, 118 S. Ct. 1125, 140 L. Ed. 2d 254 (1998). As will be discussed below, that case rejects *Scorpio* to the extent that it accords a first-sale defense to imported items. But its holding is arguably limited to the reimportation of goods initially manufactured in the United States, and thus can be read as harmonizing with *Scorpio*’s importation bar on goods manufactured and initially sold abroad. See § 8.12[B][6][c] *infra*.

That is how the footnote read from 2011 back to 2005, which is as far back as my records go. Neither former footnote 104 (as far as I can track it) nor revised footnote 363 contains the precise language you quote. I do not doubt the accuracy of the attribution; I simply cannot confirm it. But the conclusion in the present footnote is similar.

In case it’s helpful, that conclusion also appears on pages 8-184.34 and 8-184.35:

Ironically, therefore, the Eastern District of Pennsylvania’s opinion on the subject—which, albeit subject to endless discord, probably represented the best construction of the 1976 Act before the Supreme Court spoke—*de facto* remains

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<sup>168</sup> *Summit Technology, Inc. v. High-Line Medical Instruments Co.*, 922 F. Supp. 299, 312 (C.D. Cal. 1996) (quoting 2 M. NIMMER & D. NIMMER, *supra* note 61, § 8.12 [B][6] n.104).

so even after. 457 If so, then the Copyright Act, subject to the various twists and turns catalogued above, in gross fashion should still be interpreted to bar the importation of gray market goods 458 that have been manufactured abroad.

I regret that I cannot confirm the contents of the earlier version of footnote 104, but hope that the updated treatment of that topic as set out above will be of some help.<sup>169</sup>

In fairness, the introductory material to the hard copy Nimmer treatise includes a statement recommending that, if you are relying on something in it, you should make a copy of the pages because of the nature of loose leaf publications. So David Nimmer is aware of the issue of disappearing law and makes an effort to alert treatise users about the problem. But he does nothing to solve it. Old versions of the treatise are apparently not maintained for posterity, at least not in a way that is accessible to those who use it.

“Link rot” poses perennial difficulties,<sup>170</sup> but at least if a statute changes, one can find evidence of the amendments in the annotations to the statute itself. It is a simple matter to ascertain what the changes were, when they were made, and even why they were made, at least to some extent, by perusing the legislative history and any contemporary media accounts. When a Restatement makes changes, they are fully documented for similar reasons. This is a far superior approach on every measure.

C. *It Might Attract More Copyright Law Geeks into Greater ALI Participation*

It is a truism that you can never have too many copyright law geeks at a legal conference. At least not if you want to maximize the fun factor.

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<sup>169</sup> This is because the footnotes have been renumbered in the various versions. See E-mail exchange between Neil Myers, Editor of the Nimmer Treatise, and Cynthia Pittson, Research Librarian (Oct. 03, 2013) (on file with author) (quoting 1 M. NIMMER & D NIMMER, *supra* note 32, § 8.12).

<sup>170</sup> See Raizel Liebler & June Liebert, *Something Rotten in the State of Legal Citation: The Life Span of a United States Supreme Court Citation Containing an Internet Link* (1996–2010), 15 YALE J. L. & TECH. 273, 273 (2013), available at <http://digitalcommons.law.yale.edu/yjolt/vol15/iss2/2>.